FILED
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HAROLD B. WILLEY

IN THE

Supreme Court of the United States

No. 712

THOGER GRONBORG JUNGERSEN,

Petitioner,

against

AXEL BROS., INC., A. BLUMSTEIN, INC., FEATURE RING CO., INC., O. M. RESEN, INC., HARRY ROSENBERG CO., INC., ROTHMAN & SCHNEIDER, INC., SKALET MFG. COMPANY, INC., ROBERT BADEN, GLADYS FOSS, HARRY BERLAND, SEYMOUR BERLAND, SHERLE BERLAND, JEAN BERLAND, JACOB FLYER, HERMAN FLYER, DAVID KLEBANOFF, SAM GROSSMAN, ARTHUR CELONA and SAM TOUR,

Respondents,

and

HARRY COHAN, MAX COHAN, DAVID SELIKOFF LOUIS WITKIN, ALBERT FOSS, ANNIE BERLAND, LOUIS DOLGOV and ROSE BADEN,

Defendants.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT

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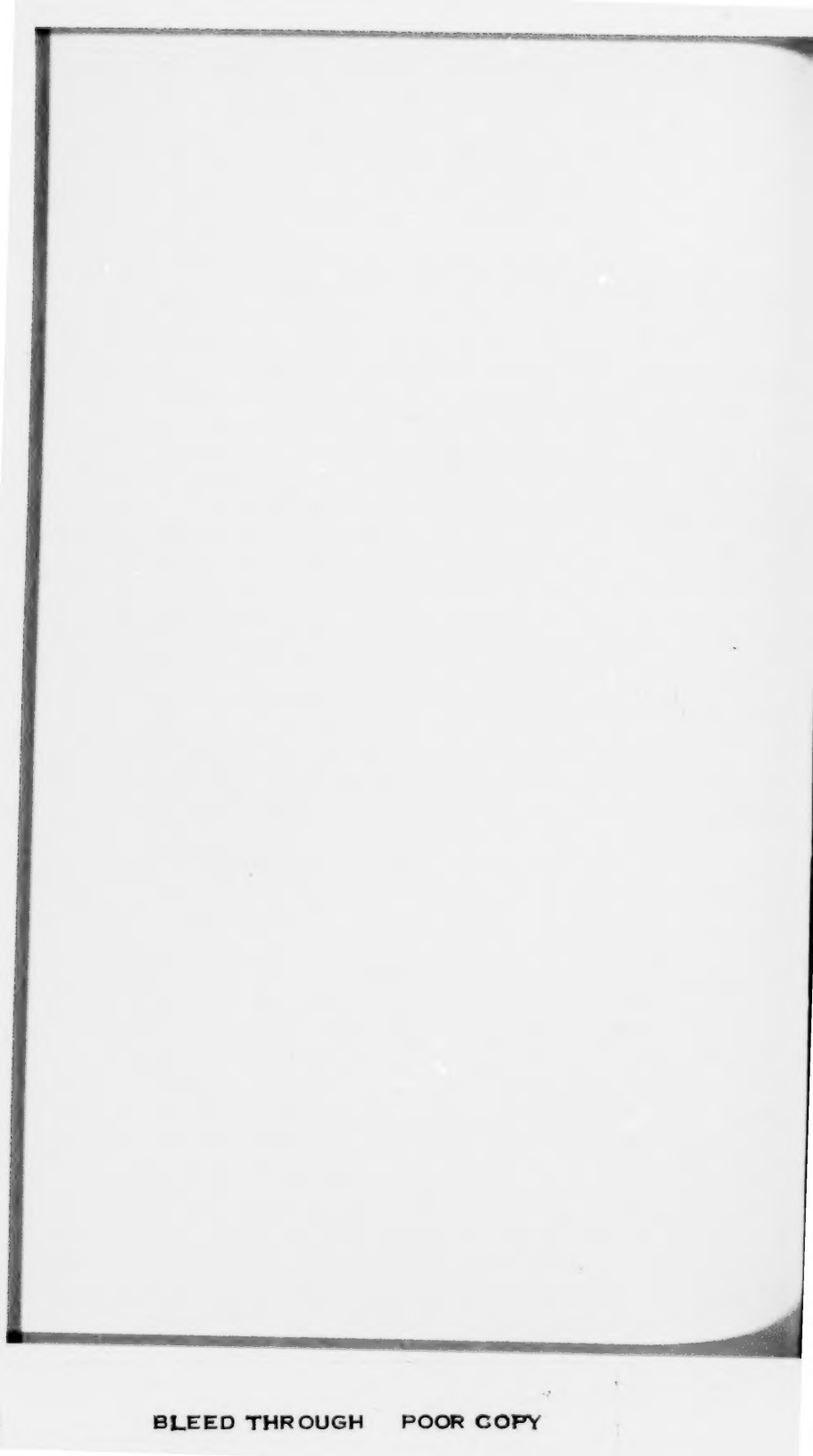
MISCELLANEOUS

Story's Equity Jurisprudence (14th Edition) Section 98 40



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PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT

To the Supreme Court of the United States:

Petitioner prays that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Second Circuit, which affirmed a judgment entered against him by the United States District Court for the Southern District of New York granting summary judgment and dismissing this action pursuant to Rule 56(b) of the Federal Rules of Civil Procedure.

Plaintiff's action was instituted to set aside, for fraud practiced upon the trial court in a patent infringement action, a judgment holding plaintiff's patent invalid for want of invention. That judgment is reported at 166 Fed. 2nd 807, affd. 335 U. S. 560.

Opinions Below

No opinion of the United States Court of Appeals, Second Circuit, was rendered. That court affirmed the summary judgment on the opinion of the District Judge, which is reported in 121 Fed. Supp. 712. The decision of the Court of Appeals is not yet reported.

Jurisdiction

The judgment of the United States Court of Appeals, Second Circuit, was entered December 20, 1954. Within the time fixed by said court, a Petition for Rehearing was timely filed. Upon consideration, the Petition for Rehearing was denied without opinion January 14, 1955. This Petition is filed within ninety days following January 14, 1955. The jurisdiction of this court is invoked under 28 U. S. C. ~~A. Rule 60(b).~~

1254 (1)

Questions Presented

1. In a suit to vacate a judgment of invalidity of a patent on the ground of planned perjured testimony relating to prior art and other relevant matter, was it error for the Court of Appeals to accept the allegations of perjury and its subordination, but to dismiss the suit on the ground that the perjury was in no way material or relevant to the grounds upon which the judgment of invalidity was rendered?

2. In deciding this case, did the Court of Appeals, Second Circuit, do so in a way in conflict with applicable decisions of this court?

Rule and Statutes Involved

The rule and statutory provisions involved are: Rule 56 (b) of the Federal Rules of Civil Procedure, as amended, 28 U. S. C., Rule 56 (b), which reads as follows:

"RULE 56. SUMMARY JUDGMENT

* * * * *

(b) *For Defending Party.* A party against whom a claim, counterclaim, or cross claim is asserted or a declaratory judgment is sought may, at any time, move with or without supporting affidavits for a summary judgment in his favor as to all or any part thereof."

Rule 60 (b) of the Federal Rules of Civil Procedure, as amended, 28 U. S. C. 60 (b), the pertinent parts of which read as follows:

"RULE 60. RELIEF FROM JUDGMENT OR ORDER

* * * * *

(b) *Mistakes; Inadvertence; Excusable Neglect; Newly Discovered Evidence; Fraud, etc.* On motion and upon such terms as are just, the court may relieve a party or his legal representative from a final judg-

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ment * * * for the following reasons: * * * (3) fraud (whether heretofore denominated intrinsic or extrinsic), misrepresentation, or other misconduct of an adverse party; * * * This rule does not limit the power of a court to entertain an independent action to * * * set aside a judgment for fraud upon the court * * * the procedure for obtaining any relief from a judgment shall be by motion as prescribed in these rules or by an independent action".

Statement

This action is a culmination of a fourteen-year fight by petitioner to right a wrong and seeks to set aside a previous judgment after trial, in an action between substantially the same parties,* holding plaintiff's patent invalid for want of invention. The ground for seeking to set aside the judgment is fraud practiced upon petitioner and the trial court, in the form of prearranged false testimony by the defendants' sole expert witness and others, which was intended to and did mislead the court by a false showing of want of invention.

After service of process in this action and before answer, the defendants moved for summary judgment on the ground that there was no genuine issue as to any material fact and that the defendants were entitled to a judgment as a matter of law (11; 31-33).**

In granting the motion, the District Judge and the Court of Appeals accepted the allegations of perjury (189; 566) which, "if proved, would entitle a litigant * * * to the relief sought" (189; 566), but held that the fraud was "completely irrelevant and immaterial to the decision of invalidity and was not the basis of the conclusion reached"

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* *Jungersen* v. *Baden, et al.*, 166 Fed. 2d 807.

** Unless otherwise indicated, reference is to page and folio in this transcript of Record (first number refers to page, second to folio).

(189; 567) by the trial court, and, that, "the alleged perjurious testimony * * * was in no way relevant to the grounds upon which the judgment of invalidity was rendered" (195; 583). The court found as a fact, that this was not a situation where the premediated plan to defraud played some part in influencing the trial court (194; 582).

The basis for federal jurisdiction of this action in the court of first instance, to set aside for fraud, a judgment holding petitioner's patent invalid for want of invention, is Federal Rules of Civil Procedure, Rule 60(b), 28 U. S. C. 60(b).

Before embarking upon a discussion of the facts, which petitioner claims, constituted the fraud, we should like to refer to *Hazel-Atlas Glass Co.* v. *Hartford Empire Co.*, 322 U. S. 238, 246. We believe that the decision of the Court of Appeals, Second Circuit, in this case, conflicts with the decision in the *Hazel* case. The holding, in the *Hazel* case, is that the degree of influence the fraud exerted upon the trial judge is not for the accused party to weigh or measure.

The criterion, we believe, according to the *Hazel* decision, is this: Since the party who introduced fraudulent evidence in a patent case, thought it material, he is in no position to dispute its effectiveness upon the court. And if the proof establishes the fraudulent evidence and its materiality (in the case at bar the fraudulent evidence is shown to have been vital), the offending party has no standing before a court of equity, and irrespective of other consideration or proof in the case, any benefit it had received from a court of equity will be vacated and set aside.

In 1938, petitioner, Thoger Jungersen, had obtained a patent on a new method of casting small articles of intricate design, *making true replicas of an original model.* It came to be known as precision or investment casting something completely unknown before in the casting industry. His method is fully described at pages 4-5, folios 12-13 of this Transcript of Record.

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Since the patentability of the Jungersen process is not in issue here, no detailed recitation of its merits will be made, except as it may be required in the discussion of the questions presented.

The basic issue on this case is this: may these defendants retain benefits fraudulently obtained?

In 1947, in the patent infringement action,* the trial judge held, after a trial in which the fraudulent evidence was introduced, that although Jungersen's process was entitled to the attribute of commercial success, the patent was invalid for want of invention. The fraudulent testimony was directed to a false showing of prior use and false expert testimony as to prior art, all of which was designed to mislead the court, which relied upon and was influenced by that testimony.

On appeal to the United States Court of Appeals for the Second Circuit, the judgment was affirmed by a 2 to 1 decision, Judge Learned Hand dissenting in an opinion which was adopted as their own in this court, by Mr. Justice Frankfurter, Mr. Justice Burton and the late Mr. Justice Jackson. In this court the judgment was affirmed by a divided court.

All the defendants in this action, excepting Sam Tour, were defendants or intervenors in the infringement action brought by petitioner. Sam Tour was the defendants' sole expert witness. It was he, primarily, in conjunction with a firm known as Ostby & Barton Company, of Providence, R. I., who gave the false testimony as to his own qualifications, his personal experience with and practicability of a prior patent—the Kralund patent—its teaching, commercial success and ability to do the same job and make the same products as are made by the Jungersen invention, and the practicability of all other prior patents and publications.

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* *Jungersen* v. *Baden, et al.*, 166 Fed. 2d 807.

These defendants came into court, not merely to defend a patent infringement action, but to seek the court's assistance by asking for a declaratory judgment. They obtained that declaratory judgment. May they retain the benefits of that judgment, obtained from a court of equity, if it be shown that, in support of the request for that assistance, they deliberately lied to the court?

The Complaint

The complaint alleges, in brief, that in the infringement suit, Sam Tour, defendants' expert, testified, with respect to a prior patent, called the Kralund patent, that he had worked with Kralund on the process, that the Kralund patent preceded and was substantially the same as Jungersen's, could do the same things and make the same articles, and that it was a practical, operative, commercially successful method of precision casting used in production at the Doehler Die Casting Company. Also, that Tour was presented as a witness with no interest in the outcome of the action, whereas in fact, he was then employed by Ostby & Barton Company, a firm that infringed this patent and suffered enormous loss of business through a consent decree signed by its largest customer (Sears, Roebuck & Company), and a firm that had subsequently failed in one attempt to have this patent declared invalid, and a firm that was secretly financing this case with knowledge of and consent to Tour's prearranged false testimony.

Then the complaint alleges that this testimony was false and known by Tour to be false in the following respects:

1. At no time did Tour work with Kralund on the Kralund process;
2. The Kralund process differs in material respects from the Jungersen process;
3. The Kralund process had been abandoned after a few months' experimental work, before Tour met Kralund, as impractical and inoperative and was never used commercially;

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4. That at the time of testifying, Tour was employed by a firm known as Ostby & Barton which had made secret contributions to the defense of the infringement suit for the purpose of destroying Jungersen's patent through the testimony of Sam Tour;
5. That all this was part of a calculated plan to deceive the trial court.

Then it is alleged that prior to the decision in the infringement action, plaintiff (petitioner) was unaware of these facts.

While there are other facts of fraud, these will suffice for the present.

1. The Relevancy and Materiality of Tour's Testimony and His Perjury.

Setting aside, for the moment, the question of the propriety of deciding disputed issues of fact on a motion for summary judgment, a comparative analysis will be made of Tour's testimony and the trial court's Findings of Fact. This, we believe, will show the materiality of Tour's expert testimony and the influence it exerted upon the trial court.

Re. Kralund

Trial Court's Findings	*Tour's Testimony*
Page 47, Folios 139-140*	Page 154, Folio 462*
"11. Kralund is concerned with commercial castings, especially *but not exclusively, of large bulk.*	"Q. . . . Does this mean that the method [Kralund process] is limited to castings of large bulk? A. It

* Where words "Page" and "Folio" are used, references are to Transcript of Record in infringement suit, *Jungersen* v. *Baden, et al.*, 166 Fed. 2d 807. The trial court's Findings of Fact and Conclusions of Law are included in this Petition as Exhibit A beginning at page 59.

Trial Court's Findings

He teaches the use of the '*cire perdue*' process with the addition of pressure derived from a die casting apparatus for the introduction of the wax into the die and for the introduction of the metal into the final mould. His primary mould is of the metal machined to its desired shape. *Kralund was directing his efforts toward the requirements of precision tool castings which are more exacting than those of jewelry casting.*" (Italics supplied.)

Tour's Testimony

does not. The method is applicable to castings of small, intermediate, as well as large size. . . ."

Then, there was read to Mr. Tour the following passage from the Kralund patent (Page 155, Folio 463): By reason of the character of the material which may be used in making the patterns above referred to, there are substantially no limitations upon the size of the castings which may be made"; and he was asked:

"Q. Now, is that a practical fact, Mr. Tour? A. That is true".

Re: the "cire perdue" process and similarity of method, Tour testified (Page 153, Folio 457): "A. With the exception of the making of an original model which Kralund does not mention, there is no difference in the system between Kralund and the patent in suit.

"Q. And you mean by that that Kralund follows the same sequence of steps as does the patent in suit;

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Trial Court's Findings *Tour's Testimony*

is that right? A. That is right, the same steps in the same sequence."

Page 153, Folio 459

"Q. Are there any steps in which there is any difference in means between Kralund and the patent in suit? A. Kralund refers to the use of pressure for making the wax or fusable metal replica without specific mention of centrifugal casting."

Page 154, Folio 460

"Q. Does he refer to pressure die casting? A. He refers to pressure die casting."

Re: Kralund's "precision" casting (Page 155, Folio 465):

"Q. Are the castings made according to the Kralund method accurate? A. They are. They are what we call now precision castings.

"Q. And how is their accuracy as compared with the necessary accuracy of jewelry castings? A. They are more accurate, and necessarily more accurate

Trial Court's Findings	*Tour's Testimony*
	than jewelry castings on the whole."
Page 49, Folio 146	Pages 150-151, Folios 450-451
"22. The evidence does not justify a finding that there is a distinct jeweler's art. The only substantial evidence on the subject was that the casting of jewelry was part of the casting art. The casting of vases, statuettes and small precision parts for tools is analogous to the casting of rings."	"Q. There has been reference here from time to time to statuary casting or jewelry casting or dental casting. Is there any such thing as statuary casting or dental casting or jewelry casting, Mr. Tour? A. They are all casting, and it makes very little difference to a caster whether the final article is going to be a piece of jewelry, a piece of statuary, or the filling for a tooth or denture, or a mechanical part. **The size of the casting, the intricacy of the casting, and the material of which it must be cast are the controlling factors, not the end use."*
Page 46, Folio 136	"Q. Is there any system having application only to one of these sub-fields and having no application to any of the others? A. No such system that I know of."
"6. The process of the patent in suit makes possible the manufacture of a few rings, or a hundred rings, more economically than by stamping processes. **The size of the casting, the intricacy of the casting, and the material of which it must be cast, are the controlling factors."*	

* The second sentence of the Finding is taken verbatim from Tour's testimony.

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Trial Court's Findings

Page 48, Folio 144

"18. By 1933 metal and rubber primary moulds were interchangeable and equivalent."

Tour's Testimony

Page 161, Folios 481-482

"Q. Now, you referred to the several different types of mold; the rubber mold of Hazeltine and Spencer, the gelatin mold of 'La Gravure' and the multipart ceramic mold of Cellini. You have also referred to the mold or die of Kralund. Will you explain whether or not molds of these various types are and have been generally and interchangeably used in the casting art? A. They have been used generally and still are used generally and interchangeably in the casting art . . ."

Notwithstanding the Kralund patent and its claims, it was necessary to show that the Kralund process did the job for which it was designed. For that purpose the following question was put to Tour (Page 154, Folio 462):

"Was the Kralund method a practical and operative method?" Tour replied, "A. Quite."

The Transcript of Record in this case contains two affidavits of Mr. Pack, vice president in charge of production of the Doehler Company. In them, Mr. Pack establishes the complete falsity of Tour's testimony on the Kralund patent. He shows that, after a few months' experimental work, the Kralund process had been abandoned in 1915, as impractical and unable to do the job for which it was designed (96; 287-288), *that no commercial castings had ever*

been made with that process (96; 287), *that Tour never worked with Kralund on the process* (97; 289) *but that he came to work for the Doehler Company five years after the abandonment in 1915 of the Kralund process as impractical* (97; 289-290).

Tour claimed many years of personal experience with and intimate, practical knowledge of the Kralund process, testifying to having worked with Kralund at the Doehler Die Casting Company on the process (Page 154, Folios 461-462).

In the trial judge's opinion (Page 32, Folio 96),* is the statement:

> "While it is unquestionably true that Kralund was directing his efforts toward the more exacting requirements of precision tool casting, it does not follow that his disclosures can be dismissed as inapplicable. Clearly both plaintiff and defendant agree that by 1933 metal and rubber primary moulds were interchangeable and equivalent."

We will first dispose of the second sentence of the above quotation. Plaintiff did not agree to any such thing. On the contrary, he strongly protested against the misleading questioning on this score, and there is nothing in the Jungersen testimony to substantiate that statement (Pages 92-98). That statement can be based only upon Tour's testimony, (Page 161, Folio 482) which reads:

> "Q. Will you explain whether or not moulds of these various types are and have been generally and interchangeably used in the casting art? A. They have been used generally and still are used generally and interchangeably in the casting art."

The trial judge's Opinion is included in this Petition as Exhibit B beginning at page 44.

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Returning now to the first sentence of the quotation, we find that this is also reflected in findings 11 and 22. Finding 11, as already indicated, reads in part (Page 47, Folio 140), as follows:

> "* * * Kralund was directing his efforts toward the requirements of precision tool castings which are more exacting than those of jewelry casting."

The Kralund patent* at no time refers to "Precision Tool Castings". This came only from Tour's testimony, which we take the liberty of again quoting (Page 155, Folio 465):

> "Q. Are the castings made in accordance with Kralund's method accurate? A. They are. They are what we call now *precision castings.*
>
> "Q. And how is their accuracy as compared with the necessary accuracy of jewelry castings? A. *They are more accurate, and necessarily more accurate than jewelry castings on the whole.*"

Then Tour was asked (Pages 155-6; Folios 465-466):

> "Q. Do such commercial castings have undercuts and projections or depressions in the article to be cast? A. A very large percentage of them do.
>
> "Q. Is there any limitation upon the intricacy of castings made by the Kralund process? A. There is no such limitation."

It is revealing that on this score the defendants' attorney, Mr. Groner, in his brief before the Supreme Court in the *Baden* case (Pages 14 and 15), emphasized the reliance that

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*Defendants' Exhibit B (Page 152, Folio 456) being Volume II of Exhibits in *Ostby & Barton Company* v. *Jungersen* (D. C. N. J.) 165 Fed. Supp., 652, affd. 163 Fed. 2d 312, case 3, revd. 335 U. S. 560 together with *Jungersen* v. *Baden et al.*, both appeals having been argued together. The Kralund patent appears at pages 414a to 416a of the *Ostby & Barton* record and made part of the *Baden* record by stipulation (Page 201, Folio 602).

the trial judge *did* place upon the testimony of Tour. He said in his brief (Page 14):

> "Mr. Tour's testimony on this score, entirely unimpeached, is revealing (155)",

and followed with Tour's above quoted testimony. Then he continued (Page 15):

> "On this score Judge Rifkind found (47, Finding 11")

and quoted Finding 11 in full, referring also to the trial judge's opinion to the same effect (Page 32, Folio 96). Concluding the point, Mr. Groner added (Page 15):

> "Jungersen shows no attribute of invention over Kralund, and Kralund anticipates the patent in suit."

In support of the motion for summary judgment, Mr. Groner took the opposite position, by stating in an affidavit, that (14; 41);

> "* * * No defense based upon an asserted prior use of the method of the Kralund patent by Doehler was pleaded in either case. *No attempt was made to prove such a use* and no court either considered such a use or held that there had been one." (Italics supplied.)

We know, however, that Tour was asked by Mr. Groner (Page 155, Folio 464), referring to Kralund:

> "Q. Was the Kralund method a practical and operative method? A. Quick (Page 154, Folio 462).
> "Q. Has the process to your knowledge been applied to the casting of small articles?"

And Tour answered:

> "A. It has been applied very extensively during this war to the casting of millions of small articles." (Page 155, Folio 464).

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We have already seen that the trial judge's reference, in Finding 22 (Page 49, Folio 146) to "small precision parts for tools" came directly from Tour's testimony, not from the Kralund patent or its claims, as did the statement in Finding 11 that Kraund's process was used in commercial castings (Page 47, Folio 139).

While, in a narrow technical sense, it is true that no public use was pleaded, an extremely weak and insufficient patent was bolstered by attempted proof through Tour that the Kralund patent went into wide public use. This was done, because, from the whole tenor of the trial court's opinion, it seems clear that the Kralund patent, as a mere publication, with nothing more, would not have been accepted as anticipating petitioner's patent. *If the defendants thought that the Kralund patent itself was sufficient proof to defeat petitioner, why, then, did they attempt to prove prior use? That attempted proof, through Tour, was considered, not only material but vital.*

Re. Other Prior Art

With respect to other prior art (Spencer, La Gravure, Hazeltine and Austenal), the trial court's Findings and Tour's testimony are set out below:

Court's Findings	*Tour's Testimony*
Page 47, Folio 139	Page 160, Folio 478
"10. Spencer's patent is primarily concerned with the making of a flexible mould for intricate designs . . ."	"Q. I will ask Mr. Tour if he will state the system as disclosed in those two patents and the publication. A. . . . In the case of both Hazeltine and La Gravure pressure is used for making the final casting. The Spencer uses a rubber mold which is backed up with a plaster of Paris cast reinforcing."
Page 46, Folio 138	
"9. Hazeltine's invention has as its object the production of a metal casting	

Court's Findings

which is a perfect copy of its model. He teaches the making of a thin rubber mould about the model, into which . . . he pours melted wax. . . . The wax model is invested with clay, after which the wax is melted out of the clay mould. He suggests . . . that the metal be poured through a pipe from a sufficient height so as to produce the required pressure . . ."

Tour's Testimony

Page 47, Folio 140

"12. La Gravure adds little to the 'cire perdue' process, except that it is explicitly applied to small pieces of jewelry. It does not teach the use of pressure in the wax casting stage but does suggest the use of steam pressure in the metal casting stage."

Page 160, Folios 479-480.

"La Gravure is a mold made up out of an elastic type of material. A gelatin mold instead of rubber. The steps in the procedure all the way through are identical with the same sequence of a model, making a mold around the model, making the wax, investing the wax, melting out the wax and making a cast."

Page 47, Folio 141

Re: the Austenal patent:

"13. . . . The process employed was identical with

Re. Austenal

Page 157 Folio 471

"Q. Go ahead, Mr. Tour. A. First, the purpose of the Austenal method is de-

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Court's Findings	*Tour's Testimony*
Jungersen's except for the use of an eye dropper to squirt the wax into the rubber mould in place of a centrifugal machine . . ."	scribed as a procedure in which to make a rubber mold in which to produce wax patterns, from which to produce a Steele backing, which is a metal casting in this case. Then the first step is the taking of a model which is the original Steele backing, and which step is precisely the same as the original model in the Jungersen patent. "The next step is to make a rubber mold around that model, vulcanizing the rubber in place, and then removing the model, which is precisely the same step as in the Jungersen patent. "The next step then is to produce a wax pattern in this rubber mold . . ."

With respect to Finding 24 (Page 49; Folio 147), which reads:

> "24. Claim 6 of the patent in suit describes an old article in terms of a process of manufacture";

none of the prior patents or publications relied upon by the defendants mentions the process and the resulting article, described in claim 6 of the Jungersen patent. This Finding is based entirely upon Tour's testimony, as already clearly shown. Tour testified on all the so-called prior art, and, with respect to each, stated that it could

—and did—do the same job as the Jungersen process. For example, the following testimony of Tour is revealing (Page 160, Folios 478-480):

"Q. You are familiar, Mr. Tour, with the Hazeltine patent, the Spencer patent and the 'La Gravure' publication? A. I am.

"Q. Is there any difference between the system as employed by those two patents and the one publication and that of the patent in suit? A. No, sir. Fundamentally they all follow the same system.

"Q. I will ask Mr. Tour if he will state the system as disclosed in those two patents and in the publication. A. The procedure in general in the three methods described is exactly the same as Jungersen's with the exception that in none of the three cases do they refer to the use of pressure in making the wax.

"In the case of both Hazeltine and La Gravure pressure is used for making the final casting.

"The Spencer uses a rubber mold which is backed up with a plaster of Paris cast reinforcing.

"The Hazeltine uses a rubber mold which is held in shape by being immersed in water, and also for the purpose of cooling.

"La Gravure is a mold made up out of an elastic type of material. A gelatin mold instead of rubber.

"The steps in the procedure all the way through are identical with the same sequence of a model, making a mold around the model, making the wax, investing the wax, melting out the wax and making a cast.

"Q. Now, you are familiar with the method of Cellini, I assume, Mr. Tour? A. Yes.

"Q. And does it follow the same broad procedure? A. That is true, the same broad procedure with the exception that his mold in which he makes the wax or prepares his wax for melting out is in effect a multipart mold made of plaster of Paris.

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"Q. What was the nature of the work achieved by Cellini in the practice of that method, Mr. Tour? A. It was recognized as the highest art in statuary and jewelry casting."

Even with respect to Cellini, the trial court's Finding 8 (Page 46, Folio 137) is based completely upon Tour's testimony regarding Cellini's method (Pages 160-161, Folios 480-481).

Tour described Cellini's method as following the same broad procedure as does petitioner except that "his mold in which he makes the wax or prepares his wax for melting out is in effect a multipart mold made of plaster of paris" (Page 160, Folio 480). Actually, Cellini describes a two-mold process. In the first, a multipart plaster mold, he makes a wax pattern or model (Page 460a, Folio 1378). He then mentions a, "last and earthen mold" (Page 461a, Folio 1381) which, earlier in his writings, he describes (Page 453a, Folio 1357-8). Thus, we see that he uses two molds, a multipart mold for making a wax model and a one-piece mold for making his metal casting. We also see that his wax model was sculptured, polished and rough edges removed and "subtle labors of fancy" added to it plus air vents (Page 460a, Folio 1380). It is clear, therefore, that Cellini's method did not follow the "same broad procedure" and could not produce an exact replica of an original model.

It is significant that Tour, in talking about Cellini, described a one-mold process in which wax was used, but in which the wax, as Tour described it, served no purpose. The trial court followed Tour's description in Finding 8.

More re. Kralund

Referring to the Kralund method, Tour was asked (Page 155, Folio 464):

"Q. And have you had to do with that casting operation?"

He replied:

"A. I have."

Tour's reference to the casting of "millions of small articles" by the Kralund process (Page 155, Folio 464) is belied by the Pack affidavits (93-101; 277-302). In 1939, Mr. Jungersen, realizing the importance of his invention to the war effort, taught and gave the U. S. and British Governments a royalty-free license to use his method of precision casting for the war effort. One of the places where his process was installed was at Frankfort Arsenal where Tour was director of the laboratory (Page 148, Folio 443).

Millions of small articles were produced at the Frankfort Arsenal, not by the Kralund process, but by the Jungersen process. The Kralund process had been abandoned in 1915 as impractical and inoperative, as stated in the Pack affidavits. This is a fact not challenged by the defendants.

Thus, in fact, Mr. Jungersen's own new products have been misrepresented in all courts as evidence against the very invention which produced them.

Mr. Jungersen was not permitted to disclose the fact that his method was hailed by the War Production Board as one of this country's outstanding new production methods. For example, it made possible the development of the jet aviation industry, due to the entirely new product it could produce, namely, a true replica of an original model in essential high fusing alloys. Prior to the Jungersen invention it was considered impossible to fabricate these high fusing alloys into intricate shapes by any then known method, because of their extreme hardness and brittleness. *All that was secret or restricted information at the time of the trial.* Petitioner had been requested by the War Production Board to make no public reference in litigation of the importance of the Jungersen method in

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war production. A member of the War Production Board was present at the trial to guard against such disclosure.

To return now to the trial court's Finding 11 that Kralund's castings were precision castings necessarily more accurate than jewelry castings, we have seen that Tour so testified. Let us examine the Kralund patent itself to ascertain whether that finding could have come from it.

Kralund, on Page 414a, line 12 of his patent*, states:

> "My invention relates to a method or art of making commercial castings and more particularly to such a method which is especially adapted for the production of castings of large bulk, * * *".

On Page 414a, beginning line 50, the patent further states:

> "When I refer to small castings I refer to those castings, the weight of which is from two to three pounds or less."

On Page 415a, line 123, the patent further states:

> "The rapidity with which a large number of patterns may be made, and the small wastage of the material from which said patterns are made, make it commercially practicable to produce castings by this method *providing such castings are of sufficiently great bulk.* The method, however, is *not* particularly adaptable to the production of small castings by reason of the relatively greater expense as compared with a pressure die casting." (Italics supplied.)

On this point, speaking about the size of Kralund's castings, Tour quoted from the Kralund patent, taking the

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* Pages 413a to 416a, *Ostby & Barton Company* v. *Jungersen.* Transcript of Record 335 U. S. 560.

following sentence out of context (Page 182, Folios 544-545):

> "By reason of the character of the material which may be used in making the patterns above referred to, there are substantially no limitations upon the size of castings which may be made" (Page 414a, line 104),

to create the impression that Kralund's process was used to make small intricate castings not in excess of two or three pounds. We see, however, that Kralund claimed ability to make castings only "providing such castings are of sufficiently *great bulk*" (italics supplied).

Assuming that the trial court had followed the Kralund patent and not Tour's testimony, he could not have found that "Kralund was directing his efforts toward the requirements of precision tool castings which are more exacting than those of jewelry casting" (Finding 11) for he would have been forced to find that Kralund was directing his efforts toward the production of castings weighing more than two to three pounds (Kralund, Page 414a, line 52) and in fact of "large bulk" (Kralund, Page 414a, line 16) and that Kralund's *primary* object was "to produce such castings under conditions whereby the mold or die will not be injuriously affected by the shrinkage, or by the high temperatures of the metal" (Kralund, Page 414a, line 86). The only relation between Kralund's work and the Jungersen patent was brought into the record by Tour's testimony. Obviously, Kralund's process would serve no purpose in jewelry casting because if it were necessary to produce machined steel dies as Kralund used, then such expensive steel dies could be used for stamping or forging without the need for a fusible pattern process; and Kralund so explained that his process was primarily for the purpose of saving his expensive steel die when producing large bulky castings, the temperature of which affected or ruined his expensive dies when the metal was directly cast therein.

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The defendants' brief after trial (infringement action) refers to Tour's Kralund testimony as follows (p. 29):

> "There can be no doubt of the practical application and success of the Kralund system. *Tour testified to that from wide personal experience both with Kralund himself * * * and during the war*". (Italics supplied.)

On appeal to the Court of Appeals (infringement case), the defendants' brief used 7 pages to discuss the Kralund patent, with a heading stating that:

> "Jungersen is Anticipated by and Does Not Represent Invention over Kralund".

And the closing sentence of that brief reads:

> "In fact, Kralund anticipates the patent in suit".

The same is true of their brief before this court, where the primary argument, comprising 5½ pages is entitled:

> "The Jungersen Patent is Invalid Because Anticipated by Kralund".

The first prior art Tour was asked about was the Kralund patent (Page 152, Folio 456). He testified that the Kralund process was substantially the same as Jungersen's, step by step, and could produce the same results, that is, a true replica in wax and metal of any intricate original model. ~~He testified that the Kralund patent used force to inject wax into steel molds; and the trial court so found~~. Then Tour testified, in response to a question of defendants' counsel, that the Kralund patent had been "applied very extensively during this war to the casting of millions of small articles" (Page 155, Folio 464). We know that none of these statements is true.

In granting summary judgment, the District Court Judge stated:

> "From an analysis of the alleged perjurious testimony and of the decisions herein it is apparent that

> the findings and opinions of the District Court, the Court of Appeals and the Supreme Court were based entirely on grounds independent of matters with which defendants Tour and Baden's testimony was concerned." (Rec., p. 193)

It is the position of the petitioner that the courts to which the District Court Judge referred did and must have based their findings and opinions, in substantial part at least, upon the testimony of Tour and not "entirely on grounds independent of matters with which" defendant Tour was concerned.

It is plain that the success which all of the courts found for the Jungersen process was partly due to the fact that Jungersen's invention did away with the need for the expensive steel dies such as were previously used in the jewelry trade and to its ability to produce an entirely new product, a true replica, in wax or metal, of an original model.

Tour's testimony, which is to the effect that all molds and dies are interchangeable and that all methods of filling a mold are interchangeable and that they were used interchangeably, must have influenced the Court of Appeals and the Supreme Court in the parts of the opinions and observations of those courts referred to by the lower courts.

Had the Court of Appeals and the Supreme Court in their opinions and observations followed the printed prior art only, they would have found:

> "* * * that Jungersen's process in its entirety had never been assembled before; no one had ever thought of combining all those steps in a single sequence. * * * From time immemorial jewelry had been manufactured by the earlier processes; so that the need, if need

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there was, had existed for years. * * * Had some technological advance held up the change, and had Jungersen made it only a short time after the obstacle had been removed, I should agree that the inference of outstanding originality would have been greatly weakened; but that was not the fact. Indeed, it is the very basis of the defense (Tour's testimony) that for years all the elements lay open and available, and that nothing was needed but the paltry modification which has proved so fruitful. * * * If all the information was at hand, why was the new combination so long delayed? What better test of invention can one ask than the detection of that which others had all along had a strong incentive to discover, but had failed to see, though all the while it lay beneath their eyes?" (Quotation from the opinion by Judge Learned Hand adopted by Mr. Justice Frankfurter and Mr. Justice Burton) (Matter in parentheses added).

If the trial court, the Court of Appeals and the Supreme Court had not relied upon Tour's testimony, then they would have found, as did Mr. Justice Jackson, in his dissenting opinion, that:

> "It would take a singular self-assurance on the part of one * * * to ignore the judgment of these competitors (defendants) who grew up in the industry and say that they did not know something new and useful when they saw it. And if Benvenuto Cellini's age-old writings are so revealing to us laymen of the Appellate Bench, it is hard to see why this practical-minded industry which the Court says was following Cellini failed through all the years to get his message."

Tour was the defendants' expert witness—a vital and indispensable witness in a patent infringement suit to guide and assist a nontechnical court to reach a technical decision. The weight and credibility of his testimony rested

with the trial judge. The weight in favor of his testimony inevitably must have been greater if he testified as a disinterested person with no axe to grind. Testimony on the Kralund and all the prior art came from Tour alone. The court's Findings as to the prior art were based upon his expert guidance, and testimony—the testimony of a man who lied about his "work" with the Kralund process, its commercial "success", the products made by it, and who misinformed the Court about all the other prior art. Those lies were part of a prearranged plan. We believe that the court may take judicial notice of the prearranged nature of expert opinion testimony. No party will offer expert testimony unless he knows in advance what that expert testimony will be. Both the plan and its execution were unknown to the court and unknown to petitioner until much later.

Had the court known of the facts now disclosed, it would have evaluated Tour's testimony in the light of those facts. The weight, if any, given his testimony must, necessarily, have been different, especially since petitioner's expert witness* contradicted Tour's testimony in almost every respect. In fact, had the trial court known of these facts, it would have been justified as a court of equity, in denying all relief to the defendants and dismissing their counterclaim for a declaratory judgment (*Hazel-Atlas Glass Co.* v. *Hartford Empire Co.*, 322 U. S. 238, 250.)

Defendants' Activities Prior to Trial of Infringement Action

After petitioner's patent application had been filed in 1934, he exhibited his process to Mr. Ostby of Ostby &

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*Mr. Joseph Robinson, formerly head engineer of Industrial Processes and Products of the Office of Production Research and Development of the War Production Board in charge of precision casting; also member of the Advisory Committee on Precision Casting of the National Research Council, also formerly Chairman, Deconcentration Review Board in Japan.

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Barton (161; 482). Upon issuance of the patent in 1938, plaintiff brought suit against Sears, Roebuck & Co. for infringement.* That suit resulted in a consent decree restricting Sears to purchase rings made only by plaintiff's licensees and a release by Mr. Jungersen to Sears and its infringing, but unknown, suppliers, among whom, it was later learned, was Ostby & Barton Company (161; 483). It was unknown to petitioner at that time that Ostby & Barton had been one of Sears' infringing suppliers (161; 483). A few days after settlement of the *Sears* case, Ostby & Barton instituted an action for a declaratory judgment in New Jersey (162; 484).**

Petitioner and his attorney then visited Ostby & Barton, where an extraordinary incident occurred (162; 484). There he was told that that firm had been "advised" that his patent was invalid (162; 485). It was learned later that the "advice" came from Sam Tour, who had been boasting that he could "break" the patent (162; 485). Then one of Ostby & Barton's attorneys, informed petitioner and his attorney that he would be "a lot smarter" if he would pay $50,000 and assign part of the patent royalties to "them" (162; 485). In return, Ostby & Barton would so conduct its case as to ensure a judgment in his favor (162; 485). This is confirmed by petitioner's then attorney (511).

Sam Tour learned of petitioner's process from Ostby & Barton (162; 486) and peddled his new-found knowledge among jewelry and other manufacturers, telling them that he had worked on a similar process known as the Kralund patent and that his testimony about that process would invalidate plaintiff's patent (162; 486, 487). Ostby & Barton agreed that Tour should so testify, although it knew that the Kralund process used no original model, so could

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* *Jungersen* v. *Sears, Roebuck & Co., Civ. Action* 1238-1940, U. S. D. C., E. D. Pa., 527 O. A. 850.

** *Ostby & Barton Company* v. *Jungersen,* 163 Fed. 2d 312.

not reproduce a true replica of an original model (the essential object of the Jungersen process) and that the Kralund process had been experimented with in 1915 for a few months and abandoned as impracticable (93; 278, 288). Tour was hired in 1921 by the company that owned the Kralund patent (97; 290) and never worked with Kralund there (97; 291), but may have "talked" with him about his abandoned experimental process (103; 309).

On February 14, 1944, petitioner instituted his infringement action in the Southern District Court (New York) against four defendants, Robert Baden, Rose Baden, Albert Foss and Gladys Foss. Subsequently all the other defendants in the instant case intervened, except Sam Tour and Ostby & Barton Company.

Prior to February 14, 1944, petitioner had sent out a number of letters warning a group of jewelry manufacturers to cease infringing his patent (161; 481). Thereafter, one Hugo Frankl, an attorney, solicited those who received the warning letters (161; 481) and obtained the signatures of a number of them (including a majority of the present defendants) to an interesting document (182 to 183; 544 to 549). That document provides that after twenty signatures are obtained, Frankl "shall" retain Fish, Richardson & Neave, Esqs., to either *prosecute* a declaratory judgment action against petitioner or "in defending any suit * * * instituted" by petitioner (182; 545-546).

After the requisite number of signatures were obtained, petitioner received from John Vaughan Groner, the attorney for the defendants in this case and a partner of Fish, Richardson & Neave, a letter demanding that either he sue for infringement or withdraw his warning letters (161; 481). He was then obliged to institute his action.

Mr. Groner was the attorney for Ostby & Barton Company in a declaratory judgment action instituted by that defendant in New Jersey (13; 37) seeking to have plain-

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tiff's patent held invalid.* Hugo J. Frankl was "of counsel" to Mr. Groner in that case and in petitioner's New York case in the joint appeal to the U. S. Supreme Court. Sam Tour was the plaintiff's expert witness in the New Jersey case (162; 486) and the sole defendants' expert witness in the New York action, while still in Ostby & Barton's employ. Ostby & Barton was not a party of record in the New York case.

The Frankl agreement required that Mr. Groner's firm "shall" be retained in the New York action. It is a reasonable assumption that an attorney will not prepare an agreement which obligates him to retain named trial counsel unless such trial counsel had agreed in advance to accept the retainer. Flowing from that is the inevitable conclusion that Mr. Groner at least knew about and acquiesced in Frankl's solicitation of clients to start a lawsuit.

Mr. Frankl's activities are explained in his own affidavit as merely "having arranged for the defendants * * * to be represented by John Vaughan Groner" (154; 461). The agreement, set out in full at folios 544-549, discloses different activities.

Ostby & Barton did not sign the Frankl agreement but made secret contributions to the defense fund (157; 471) and supplied the "expert" witness. There are two qualified denials of this charge in the record. The first is in an affidavit of Edward Winsor, a member of a firm that was, at that time, general counsel for Ostby & Barton, who says that "Ostby & Barton made no contributions of any nature at any time to the *defendants*" (italics supplied) in the patent infringement suit (152; 455, 456). There is no allegation that Ostby & Barton made contributions "to the defendants." The second is in Frankl's affidavit

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* *Ostby & Barton* v. *Jungersen*, 163 Fed. 2d 312, in which four of six Jungersen claims were held valid.

who says *he* never received any monies from Ostby & Barton "for any purpose whatsoever" (154; 461, 462).

There is no affidavit in the record of Tour or of an officer of Ostby & Barton that Tour was not paid by that firm for his services as an expert. Nor is there any denial by an officer of Ostby & Barton of plaintiff's charges of that firm's "off the record" financial contributions, its furnishing of the expert and its masterminding a fraudulent defense.

Mr. Groner himself stated in an affidavit (194; 446) that:

> "At no time did Ostby & Barton contribute a dime to the Baden defense."

In the *Baden* case, depositions were taken by Mr. Jungersen of a number of defendants and witnesses, including one Ben Axel, whose firm is also a defendant in the instant case. Those depositions are part of the record of the *Baden* case in the District Court but not of the Record on Appeal. Mr. Axel was examined on September 17, 1946. At page 135 of the stenographer's minutes, Mr. Axel was asked to produce any papers or letters in his possession bearing upon the contributions which his firm made to the defense fund in the *Baden* case. Pursuant to that demand, Mr. Axel handed Mr. Groner, his attorney, a letter (p. 137 of the stenographer's minutes), which had been sent by Hugo Frankl to Axel Bros., Inc. on October 24, 1944. Mr. Groner then read into the record one paragraph of that letter. The paragraph, with Mr. Groner's interpolations, is:*

> "The work entailed a great deal in time and expenses—(I am deleting certain parts)—than was originally contemplated, and as a result the sum of $5,000 heretofore remitted to said law firm—that is, Fish, Richardson and Neave—has been used up, *despite the*

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* Exhibit C, this petition.

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fact that Ostby & Barton bore a substantial portion of such expense." (Italics supplied.) (Matter in parentheses are Mr. Groner's interpolations.)

As already stated, Tour testified as an expert for Ostby & Barton in its New Jersey declaratory judgment action, with only limited success, for four of six claims of the Jungersen patent were held valid. In that case Tour acknowledged that he was a "consultant" for the plaintiff Ostby & Barton.* In the New York case, a year or so later, he concealed that connection, hoping, no doubt, that his testimony would be more highly regarded if it appeared that he had no interest in the case.** Actually, however, this was Ostby & Barton's "second try" at invalidating plaintiff's patent. As the trial court found in this case, the evidence "clearly supports a finding" of commercial success of Jungersen's process.*** And while Ostby & Barton was held, in the New Jersey case,**** not to have infringed, the evidence in that case did not include its infringement while making rings for Sears, Roebuck, because of a general release given to *Sears* which included its then unknown suppliers. But the result of the *Sears* case lost Ostby & Barton a valuable and profitable customer. The first try at retaliation (the New Jersey case) was not successful. The second try (this New York case), avoiding the "mistakes" of the first try, produced the desired result.

Tour's motive in falsifying evidence in an attempt to invalidate petitioner's patent was twofold. Ostby & Bar-

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* *Ostby & Barton, et ano.*, v. *Jungersen*, 163 Fed. 2d 312, Transcript of Record, folio 437.

** While portions of the record in the New Jersey case were made part of the Record in the *Baden* case, Tour's testimony was not included.

*** *Jungersen* v. *Robert Baden, et al.*, 166 Fed. 2d 807, page 30, folio 90.

**** *Ostby & Barton* v. *Jungersen*, 163 Fed. 312, Transcript of Record, folios 116-117.

ton was his employer paying him a salary or fee as a consultant. If he could do what Ostby & Barton desired, his additional value to that firm no doubt would be measured in dollars. Second, he, himself, was offering to teach plaintiff's process to others, for a fee (162; 486-7) while he was testifying that petitioner's process was "old stuff". Tour does not deny this. Tour also organized the Met-Chem Corporation. One of its directors was Mr. Groner. Acting through that corporation, Tour and his associates taught and installed plaintiff's process, under the name of the Met-Chem process, in a number of factories. Three of them, American Abrasives Company, Midwest Foundry and a Swiss company, paid a total of approximately $135,000 in fees or commissions. Unfortunately, this is not in the record, as its discovery was made after the summary judgment motion had been decided.

Ostby & Barton's motive was retaliation for the loss of its customer, Sears-Roebuck, one of the largest, if not *the* largest merchandisers in the world. Ostby & Barton's machinations, with the help of Mr. Groner, included an abortive attempt in Los Angeles to manufacture perjurious testimony for use in the *Baden* case (163; 489-490), a charge nowhere denied by these defendants or by Mr. Groner.

2. Conflict of Decisions

In *Hazel-Atlas Glass Co.* v. *Hartford Empire Co.*, 322 U. S. 238, 245, 250, this court held that when a party prepares in advance false testimony and gives that false testimony in an attempt to win his case, the fraud thus practiced upon the Court demands the exercise of the historic power of equity to set aside a judgment obtained by that party and to deny him any relief whatever.

The *Hazel* case is singularly a case in point and merits extended discussion.

In the original trial between *Hazel* and *Hartford* involving the validity of Hartford's patent, the patent was held invalid in the District Court on the ground that the patent was at best, "but a slight improvement in a well developed art" of glass making (*Hazel-Atlas Glass Co.* v. *Hartford Empire Co.*, 39 Fed. 2d 111, 120). On appeal to the Circuit Court of Appeals, Hartford, for the first time, brought to the attention of that court a certain article which appeared in a trade journal. That article was devoted exclusively to a discussion of Hartford's patent, analyzed the effect of the patented machinery upon the industry concerned, and purported to show that labor in that industry welcomed the patented machinery with open arms as a completely new and beneficial device, both to industry as a whole and to labor.

The article had not been introduced in evidence nor referred to on the trial, nor brought to the attention of the trial judge, although it was part of a voluminous file-wrapper of the patent office which had been introduced in evidence. It was referred to at length, and for the first time, by Hartford before the Circuit Court, with no attack on it having been made by *Hazel* except to call a chart "misleading" (*Hazel-Atlas Glass Co.* v. *Hartford Empire Co.*, 59 Fed. 2d 399). The Circuit Court reversed the District Court and held the patent valid. In its opinion it referred to this article (*Hazel-Atlas Glass Co.* v. *Hartford Empire Co.*, 59 Fed. 2d 399).

At the time of the trial, Hazel knew that the article had not been written by the person whose name appeared as author, but by an attorney for Hartford (*Hazel-Atlas Glass Co.* v. *Hartford Empire Co.*, 137 Fed. 2d 764). The ostensible author, Clarke, was the president of the union in that industry. After the judgment holding the patent invalid had been reversed by the Circuit Court (*Hazel-Atlas Glass Co.* v. *Hartford Empire Co.*, 59 Fed. 2d 399), Hazel then, for the first time, conducted an

investigation in an attempt to obtain actual proof of the fraudulent nature of the article. It was unsuccessful at that time, and in July, 1932 (the trial was held in 1929 and the judgment was rendered by the Circuit Court in 1932), entered into a settlement and cross-licensing agreement with Hartford.

Actual proof of Hartford's fraud was brought to light for the first time in 1941 in a government anti-trust action against Hartford. On the basis of the disclosure in the anti-trust suit, Hazel instituted a new proceeding in the Circuit Court where the fraud had taken place, to set aside the judgment upholding the validity of Hartford's patent (137 Fed. 2d 764). This new proceeding was instituted in 1941, thirteen years after the original infringement suit had been started and nine years after the Circuit Court had reversed and held the patent valid.

It must be remembered, that Hazel knew at the time of the trial in 1929 that the article was spurious (although factually true), and knew the identity of the real author, but had not actual proof which would satisfy a court. Objection was made by Hartford that relief could not be granted, because (1) it was not sought within the proper term of the court, and (2) that Hazel knew all about the fraud at the time of trial and did nothing about it for thirteen years.

With respect to the first point, this court observed, at page 244*:

> "* * * From the beginning there has existed alongside the term rule, a rule of equity to the effect that under certain circumstances, one of which is after discovered fraud, relief will be granted against judgments, regardless of the term of their entry (citing

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* *Hazel-Atlas Glass Co.* v. *Hartford Empire Co.*, 322 U. S. 238.

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Marshall v. *Holmes*, 141 U. S. 589). * * * where enforcement of the judgment is 'manifestly unconscionable' (*Pickford* v. *Talbott*, 225 U. S. 651, 657), they have wielded the power without hesitation."

With respect to the second objection, namely, that Hazel knew all about it at the time of the trial, the Supreme Court observed at page 246:

"We cannot easily understand how, under the admitted facts, Hazel should have been expected to do more than it did to uncover the fraud. But even if Hazel did not exercise the highest degree of diligence, Hartford's fraud cannot be condoned for that reason alone. This matter does not concern only private parties. There are issues of great moment to the public in a patent suit. *Mercoid Corpn.* v. *Mid-Continent Investment Co.*, 314 U. S. 488. Furthermore, tampering with the administration of justice in the manner indisputably shown here involves far more than an injury to a single litigant. It is a wrong against the institution set up to protect and safeguard the public, institutions in which fraud cannot complacently be tolerated consistently with the good order of society. Surely it cannot be that preservation of the integrity of the judicial process must always wait upon the diligence of litigants. The public welfare demand that the agencies of public justice be not so impotent that they must always be mute and helpless victims of deception and fraud."

A further point made by defendants in this case is that the false testimony of Tour and Baden was not basic to the Trial Court's decision; and that even though they may have committed perjury, and even though it may have been done pursuant to a pre-determined and calculated plan, no fraud was committed because it was not the primary basis for the decision. This also was an issue raised

in the *Hazel* case, and of that, this court held, at page 246:

> "Whether or not it (the spurious article) was the primary basis for the ruling, the article did impress the Court as shown by the Court's opinion. Doubtless, it is wholly impossible to accurately appraise the influence that the article exerted on the judges. *But we do not think the circumstances call for such an attempted appraisal.* Hartford's officials and lawyers thought the article material. * * * They are in no position now to dispute its effectiveness." (Italics in original.)

The defendants here thought Tour's testimony on the Kralund patent was material. They said so directly in their brief submitted to this court, the Court of Appeals and the District Court. They thought that Tour was an important and necessary expert witness. They thought that Baden's testimony as to when he first used plaintiff's process was material. They, like Hartford, are in no position to dispute the effectiveness of that testimony, nor, as this court observed, is it meet to attempt such an appraisal.

There is one further observation to be made regarding the *Hazel* case. It is true that the Circuit Court quoted extensively from the spurious article in holding the Hartford patent valid. However, in refusing Hazel permission to reopen the case (a decision in which Judge Biggs was the lone dissenter), the Court claimed (137 Fed. 2d 764) that:

> "* * * wholly apart from the Clarke article, the majority of the court * * * upon turning to the proofs, drew their own conclusions in support of the action which the court thereupon took" (holding the patent valid).

To prove that its original decision would have been the same and was neither based upon nor influenced by the

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article, the court pointed out that a companion application (*Shawkee Mfg. Co.* v. *Hartford Empire Co.,* 68 Fed. 2d 726), involving the identical issue, was decided the same way with no reference to the article, although the spurious authorship of the article had been brought to the full Court's attention (the same Judges sitting in both cases).

So in this case, it is no answer to argue that the decisions of the trial court, the Court of Appeals and this court, would have been the same without Tour's planned perjurious testimony. We are concerned here, not with the validity of a patent, nor with the soundness or otherwise of a judgment. We are concerned with a judgment obtained by fraud, by the deliberate use of perjury. As this court observed in the *Hazel* case, the parties who offered the perjurious testimony are in no position to dispute its effectiveness. As between two parties, one innocent and the other guilty of fraud, the latter must suffer the consequences of his wrong-doing. Certainly, the wrong-doer may neither benefit from his evil, nor retain benefit previously received.

Shawkee had joined with Hazel in seeking to reopen its case; and they jointly appealed to this court whose decision applied to both cases. Thus this court's opinion in the *Hazel* case applies to the same fraud in both cases, even though in one there is no indication in the Circuit Court's opinion that it had been influenced or impressed in the slightest degree with the Clarke article.

After the Circuit Court upheld the patent in the *Shawkee* case, Shawkee petitioned for a rehearing which was denied. Certiorari was asked and denied twice (*Shawkee Mfg. Co.* v. *Hartford Empire Co.,* 292 U. S. 640, 293 U. S. 600). Later two petitions (one, to file a bill of review and, three years later, one for a rehearing) were denied. In all those moves the true nature of the article was stressed (*Shawkee Mfg. Co.* v. *Hartford Empire Co.,* 137 Fed. 2d 764).

Hazel's activities were these. Although knowing of the spurious nature of the article at the trial, it said nothing. On the appeal, it contented itself merely with disputing the accuracy of a chart contained in the article. After the decision of the Circuit Court, Hazel employed investigators and obtained affidavits attributing authorship to one Hatch, not Clarke. Those affidavits were not brought to the Circuit Court's attention. No petition for a rehearing was filed; but Hazel gave up the battle and entered into a settlement and cross-licensing agreement with Hartford (*Hazel-Atlas Glass Co.* v. *Hartford Empire Co.*, 137 Fed. 2d 164). Thirteen years later, after the true nature of the article had been disclosed in a government anti-trust suit against Hartford, Hazel brought the proceeding which culminated in the United States Supreme Court decision penalizing Hartford for its fraud.

As for this petitioner, the false nature of Tour's testimony was unknown to him at the trial (166; 466). Partial knowledge came to him prior to argument of the appeal before the Supreme Court. Not until much later did he discover that Tour's testimony was the execution of a well-designed and premeditated plan (156; 466).

A month or two after the Supreme Court decision, petitioner began a long series of activities, legal and investigative, in an attempt to uncover defendants' machinations (158; 474-477; 162; 486-493, 167; 499, 169; 506-510, 173; 518-519, 180; 538-542). Unlike the situation in the *Hazel* case, plaintiff never abandoned the chase.

Whether an aggrieved party had or had not been diligent in protecting his rights, is not the controlling factor (*Hazel-Atlas Glass Co.* v. *Hartford Empire Co.*, 322 U. S. 238, 246). What is controlling is the answer to one question. Did these defendants regard Tour's false testimony as material? We think it is shown in this case that the question must be answered affirmatively. That being so, the party that perpetrated the fraud must be deprived of

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any and all benefit flowing to him from a judgment in his favor. To do this requires a complete denial of the relief that these defendants obtained. The answers of the defendants and intervenors were identical. Both sought affirmative relief from the court in the form of a declaratory judgment* (*Hazel-Atlas Glass Co.* v. *Hartford Empire Co., supra*).

We believe that the Court of Appeals erred in its understanding of the import of the *Hazel* decision, and that its decision in this case is in direct conflict with this Court's holding in the *Hazel* and similar cases.

Summary

It has been shown, we believe, that the judgment in the *Baden* case (and, for that matter, the judgment in the *Ostby & Barton* case, where the same fraud occurred), should be vacated and set aside. The defendants' fraud prevented a fair trial of the issues, involving far more than injury to petitioner, serious as that injury is. The fraud was "a wrong against the institution set up to protect and safeguard the public, institutions in which fraud cannot complacently be tolerated consistently with the good order of society" (*Hazel-Atlas Glass Co.* v. *Hartford Empire Co.*, 322 U. S. 238). Defendants failed to meet the requirement, exacted of all suitors in equity, that, "they shall have acted fairly and without fraud or deceit as to the controversy in issue" (*Precision Co.* v. *Automotive Co.*, 324 U. S. 806, 814-815).

In the *Precision* case where the history of the patents was "steeped in perjury," this court said (p. 815):

> "Moreover, where a suit in equity concerns the public interest as well as the private interests of the litigants this doctrine assumes even wider and more significant proportions. For if an equity court prop-

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* Page 14, folio 40 and page 23, folio 68.

erly uses the maxim to withhold its assistance in such a case it not only prevents a wrongdoer from enjoying the fruits of its transgression but averts an injury to the public * * *."

The trial of the infringement case was permeated with corruption—undisclosed corruption. Defendants sought to persuade the trial court to see things their way by presenting—and vouching for—an expert technical witness, with the intent to misguide the court on highly technical matters. An expert witness testifies at the discretion of the trial court. If a trial court feels that it requires no expert guidance because the subject of an expert's proposed testimony is within general knowledge, it is the court's prerogative to refuse to hear the expert. In this case, the trial court apparently felt that it would benefit from an expert's testimony on the prior art and on the patent in suit, as to their similarities or differences and as to their ability to do the jobs for which they were designed. It relied heavily upon the expert's explanation of all the patents and based many of its findings upon his testimony. It was unaware that much of that testimony was false, and that the expert was in the pay of one who was secretly financing the defense. It was misled and made the unwitting instrument of defendants' fraud.

Conclusion

While we have seen that in his Findings and Opinion, the trial court leaned heavily upon the testimony of Sam Tour, the defendants' expert witness, we also have seen that, in their briefs in all courts, the defendants themselves regarded Tour's testimony on Kralund as weighing the scales against petitioner. We have seen that the defendants were not "frank and fair with the court" (Story's Equity Jurisprudence, 14th Ed., Section 98); that Tour was offered to the court as a disinterested witness with

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expert and first hand knowledge of the Kralund process when in fact he was no such thing; that a process that had been abandoned in its experimental stage as impractical and inoperative was offered as an impediment to petitioner's patent on the ground that it was used commercially before petitioner's invention; that Tour's false testimony was the culmination of a concerted and prearranged plan to defraud the court; and that, even in this case, attempts were made to mislead the court.

Whether or not it can be said that a retrial of the infringement suit, without Tour's testimony on Kralund and the other patents, would again result in a decision of invalidity of petitioner's patent on the ground that a new combination of old steps is not invention, it may not operate to mitigate or excuse defendants' fraud. (Petitioner's process, combined old, isolated and separately used processes, into one new process which produced a completely new product—*an exact replica of an original model.* Virtually every new invention ever patented is a new combination of old elements or steps known somewhere, someplace before. The real invention lies in the new effect or the new product produced by a specific new combination.)

A similar argument was used by the parties who defrauded the court in the *Hazel* case. There the Circuit Court said, in effect, "our decision would have been the same without the offending article". This court, in its *Hazel* opinion, placed the emphasis where it belonged. It considered only one question, were the defendants guilty of obtaining a possibly correct decision by fraudulent means? If they were, they may not receive nor retain any benefit at the hands of an equity court, no matter how they might have fared had their conduct of the case been above reproach.

The defendants regarded Tour's testimony as material. In offering him as a witness, they vouched for his integrity, knowing that he was going to mislead the court on vital

aspects of his testimony. Even if it be argued that Tour's testimony exerted no influence whatever, upon the trial court, is an *attempt* to defraud an equity court less reprehensible? Is planned perjury in a patent case, therefore, to be condoned and ignored, when the perjurious testimony is offered and regarded as material but may not have influenced the court?

We believe that the holding in the *Hazel* case answers these questions in the negative. How much more so, then, should the fraud be condemned when it *did* influence the court?

Having "accepted" the fact of planned fraud, the Court of Appeals, which affirmed the summary judgment on the opinion of the District Judge, erred in finding as a fact, without a trial, that the fraud was neither material nor relevant to the finding of invalidity and exerted no influence upon the trial court.

It is respectfully requested, therefore, that a Writ of Certiorari be granted to review and correct the errors of the Court of Appeals.

Respectfully submitted,

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Exhibit A.

Findings of Fact and Conclusions of Law.

(Filed Apr. 5, 1947)

UNITED STATES DISTRICT COURT,

SOUTHERN DISTRICT OF NEW YORK.

[SAME TITLE.]

This cause having been tried to the court without a jury the court finds the facts and states its conclusions of law, as follows:

Findings of Fact

1. This is an action for patent infringement, brought by plaintiff, the owner of Jungersen Patent No. 2,118,468, against defendants, a partnership, resident and doing business in the City of New York, in the Southern District of New York. Seven corporations and fifteen individuals, comprising six partnerships, have intervened and are parties defendants herein.

2. The Jungersen patent No. 2,118,468, applied for September 28, 1934 and issued May 24, 1938, contains six claims. The specification of the Jungersen patent is addressed to a method of casting of small metal articles, particularly articles of intricate detail and the steps in the process of the Jungersen patent are as follows:

a. A model of the article to be cast is made of wood, metal or other suitable material.

b. This model is placed upon a base and a flexible mould-forming material such as rubber, is built up around the model and vulcanized. The mould is then separated into half sections.

c. After removing the model from the mould, the two half sections are brought together again and a suitable quantity of a very low temperature fusing material which may be wax or a metallic alloy such as Wood's metal, is poured into the gate of the mould and the mould is rotated rapidly in a centrifugal casting machine. The wax is thus forced into the cavity of the mould.

d. The wax pattern thus produced is removed from the mould by separating the half sections of the mould. It is then invested in plaster of Paris which will form a suitable mould for the metal which it is ultimately desired to form to that shape.

e. The investing material may be dried out in any suitable manner but in any event the mould created by the plaster of Paris is subjected to sufficient heat to melt the wax and all traces of this wax are completely removed from the mould.

f. The cavity within the plaster mould conforms to the wax pattern. The mould (investment) is then placed in a centrifugal casting machine and the molten metal from which the casting is to be made is poured into this mould and is projected by the applied force of the centrifugal action into the fine recesses. The mould is then broken up and the metal replica of the original model is abstracted.

3. All the defendants use the several steps of the process with the following variations:

a. For the primary mould some use soft metal moulds as well as rubber moulds. The metal moulds so used are made of a very soft metal which has a melting point of about 200° F. and this primary mould is built up of a number of parts by flowing this soft low fusing metal over the exposed por-

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tion of the model so as to take the shape of the mould in negative; and this soft metal mould is not machined.

b. To inject the wax into the primary mould all use a centrifuge and some also use an eye dropper or syringe, air gun, air injection machine, hydraulic machine and vacuum casting machine.

In view of the findings and conclusions as to validity, no finding is made as to whether or not these variant methods are infringements. To the extent that defendants have used centrifugal force to deposit the wax into a primary mould, and all have, there can be no question that they have infringed.

4. At the time plaintiff conceived his process in December, 1933, the jewelry manufacturing industry, including these defendants, generally used one or more of the following four methods: Hand-fashioning by skilled artisans; cuttle-fish casting, which necessitated hand-finishing the rough casting by skilled jewelry mechanics; sand casting, which also required hand-finishing by skilled jewelry mechanics; and die stamping, which is efficient when numerous rings of a similar design are desired but which has a high initial cost, the dies for the single ring design costing from $250.00 to $2,000.00.

5. Since the introduction into the jewelry trade of the Jungersen process, cuttlefish casting and sand casting are of little commercial significance. Die stamping and the process of the Jungersen patent are the only substantial methods now commercially used in the production of jewelry. His process, as described and claimed in the patent in suit, has been extensively employed in the manufacture of jewelry and is entitled to the attribute of commercial success.

6. The process of the patent in suit makes possible the manufacture of a few rings, or a hundred rings, more economically than by stamping processes. The size of the casting, the intricacy of the casting, and the material of which it must be cast, are the controlling factors.

7. The following prior patents and prior applications are relevant to the prior art: Spencer No. 748,996 of 1904; Haseltine (British) No. 2467 of 1875; Kralund No. 1,238,789 of 1917; "The Treatises of Benvenuto Cellini of Goldsmithing and Sculpture" from the 16th Century; "La Gravure," by Verleye, received in the United States on or before September 11, 1926. This also is true of the prior public use of the Austenal Laboratory in New York and Chicago in 1932-1933.

8. Cellini describes in minute detail the "cire perdue" or lost wax process as applied to the casting in bronze of figures of life size or under. The features which distinguish it from the patented process are that Cellini does not use a rubber mould but one made of "Gesso," that is, plaster of Paris or gypsum; he pours his wax, apparently employing no force but gravity to fill his mould; and when the wax is melted out, he allows the molten bronze to flow into its place, again without the use of pressure.

9. Haseltine's invention has as its object the production of a metal casting which is a perfect copy of its model. He teaches the making of a thin rubber mould about the model, into which mould, when freed from the model, he pours melted wax. To help the thin rubber retain its shape, he suggests its suspension in water. The wax model is invested with clay, after which the wax is melted out of the clay mould. He suggests that ordinary pouring of the metal into the clay mould will not give clear definition of lines and therefore recommends that the metal

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be poured through a pipe from a sufficient height so as to produce the required pressure. Illustratively he speaks of a statuette and in his drawing he shows a vase.

10. Spencer's patent is primarily concerned with the making of a flexible mould for intricate designs. Neither with respect to wax nor metal does he teach the use of force or pressure for the injection into the mould.

11. Kralund is concerned with commercial castings, especially but not exclusively, of large bulk. He teaches the use of the "cire perdue" process with the addition of pressure derived from a die casting apparatus for the introduction of the wax into the die and for the introduction of the metal into the final mould. His primary mould is of metal machined to its desired shape. Kralund was directing his efforts toward the requirements of precision tool castings which are more exacting than those of jewelry casting.

12. La Gravure adds little to the "cire perdue" process, except that it is explicitly applied to small pieces of jewelry. It does not teach the use of pressure in the wax casting stage but does suggest the use of steam pressure in the metal casting stage.

13. During 1932-1933, the Austenal Laboratories in Chicago, developed a method of reproducing "Steele's Backings" for the dental trade. A Steele's Backing is a small undercut metal rail which fits into a channel of an artifical tooth and is used to secure the tooth to the dental plate. The process employed was identical with Jungersen's except for the use of an eye dropper to squirt the wax into the rubber mould in place of a centrifugal machine. For casting the metal Austenal em-

ployed a centrifugal machine or air pressure. I read the testimony on the Austenal use to show the employment of an eye dropper or syringe for the introduction of the wax but (though a syringe is capable of generating force) not for the purpose of applying force, and without the effect of pressure. The process met with only moderate success, was used for about a year and then superseded by a superior process.

14. Of the above references only Haseltine and Spencer were before the Patent Office.

15. Jungersen's British patent, the substantial equivalent of the patent in suit, admits that every step in the process of the patent in suit except the means of casting the wax and the metal was old.

16. The Slatis-Dee method purports to be identical with Jungersen's. However, defendants agree that it does not anticipate because secret and the Slatis-Dee use is not an anticipation of the Jungersen process or his product.

17. Jungersen's testimony concerning his invention shows that his work, which resulted in the patent in suit, was undertaken on a bet and employed known materials and appliances to accomplish known and expected results, and only later did he hear that he had done something which was thought to be unusual.

18. By 1933 metal and rubber primary mould were interchangeable and equivalent.

19. The use of force for casting metal is old; Haseltine, La Gravure and Kralund taught it. The need of force for casting wax was taught by Kralund who used a die casting machine. Plaintiff practically concedes the equivalence of the several modes for the application of force—

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namely, syringes, air pressure and centrifugal machines. The substitution of centrifugal force for other means of casting the wax is not invention, but the application of an equivalent means.

20. Once the use of force for the introduction of the wax into the mould was known to be desirable—and Kralund showed it—the choice of alternative means for the application of force became a non-inventive application of the skill of the caster's art.

21. In the casting art it was old knowledge that the forced introduction of molten material into a mould produced greater definition of line and contour and greater fidelity of reproduction. McManus' patent showed the use of a centrifugal machine as the source of force for such purpose, which lent itself especially to small casting, specifically including jewelry. Were it at that time desired to make faithful wax castings, as the final article of manufacture, it would not amount to invention to introduce the wax into the mould by centrifugal force. Nor does it amount to invention when casting the wax pattern is an intermediate step in a longer process.

22. The evidence does not justify a finding that there is a distinct jeweler's art. The only substantial evidence on the subject was that the casting of jewelry was part of the casting art. The casting of vases, statuettes and small precision parts for tools is analogous to the castings of rings.

23. The specification of the patent in suit is not limited to jewelry casting and by its specific terms is brought within the casting art.

24. Claim 6 of the patent in suit describes an old article in terms of a process of manufacture.

Conclusions of Law.

1. All of the claims of the patent in suit are invalid because anticipated and for want of invention.

2. Claim 6 of the patent in suit is also invalid because it describes an old article in terms of a process of manufacture.

3. A judgment may be entered in defendants' favor adjudging all of said claims invalid and void, enjoining plaintiff or anyone in privity with him from bringing or prosecuting or threatening to bring or prosecute any civil action charging infringement of said patent No. 2,118,468, or any claim or claims thereof against the defendants, or any of them, or their agents, vendees or others in privity with them, or any of them, and awarding defendants their costs to be taxed against plaintiff.

Dated, New York, N. Y., April 4th, 1947.

SIMON H. RIFKIND
U. S. D. J.

Exhibit B.

Opinion.

(Filed Feb. 7, 1947.)

UNITED STATES DISTRICT COURT,

SOUTHERN DISTRICT OF NEW YORK.

[SAME TITLE.]

Drury W. Cooper, Esq., John N. Cooper, Esq., Karl W. Flocks, Esq., Attorneys for Plaintiff.

Fish, Richardson & Neave, Esqs., Attorneys for Defendants; John Vaughan Groner, Esq., Robert B. Whittredge, Esq., of counsel.

RIFKIND, D. J.:

In this patent infringement suit plaintiff seeks judgment for damages, profits and injunctive relief. The answers put in issue both validity and infringement and contain counterclaims for declaratory judgment adjudicating the validity of the patent.

The patent in suit is No. 2,118,468 issued to plaintiff on May 24, 1938, on an application filed September 28, 1934. It contains six claims of which the first five relate to a method of casting articles of jewelry of intricate design, and the sixth is for an article of jewelry produced by the method.

Claim 2 reads as follows:

> "2. A method of casting articles of jewelry of intricate design consisting in, first making a model of the article desired to be cast, then forming a primary mould in separable sections there-around of plastic material capable of assuming intimate contact with the intricate designs of the model and adapted to retain the assumed shape, then removing

the model, then by centrifugal force projecting into the mould cavity and completely filling same a molten material of a low fusing point which will not injure the mould, then removing the fusible pattern so cast, then investing said pattern in a refractory material which will assume all the contours of its intricate design to form a secondary mould, then heat treating said investment removing the low fusing pattern therefrom, then by centrifugal force projecting molten metal into the heat treated mould, and finally removing said mould from the cast article."

Claims 1, 3, 4 and 5 describe variants of the method. Claim 6 reads as follows:

"6. An article of jewelry or a part thereof of a design intricate to the extent of having one or more small projections or depressions made by a process comprising first producing a model of the article to be cast, then forming about said model a primary mould, then removing the model from the primary mould, then introducing into the mould by force sufficient to deposit the material into the depression or depressions of the primary mould, molten wax or other material of low fusing point that will not injure the primary mould to form a a pattern, and employing the pattern so made for the manufacture of a casting mould."

In the specifications the object and the several steps of the process are thus described:

"The principal object of this invention is to facilitate the casting of small metal articles, particularly articles of intricate detail such as jewelry which frequently are designed with hollows, under-

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cut portions and perforations, so that they will have a smooth clean surface faithful in detail to the original and free from imperfections or holes, and to enable such result being accomplished with the minimum of expense.

"A further object of the invention is to enable the formation of intricate castings which will so closely resemble the original and finished product that the slow and tedious work of patterning and detail cutting required in connection with present casting methods is eliminated."

The steps in the process are these:

1. A model of the article to be cast is made of wood, metal or other suitable material.

2. This model is placed upon a base and a flexible mould-forming material such as rubber, is built up around the model and vulcanized. The mould is then separated into half sections.

3. After removing the model from the mould, the two half sections are brought together again and a suitable quantity of a very low temperature fusing material which may be wax or a metallic alloy such as Wood's metal, is poured into the gate of the mould and the mould is rotated rapidly in a centrifugal casting machine. The wax is thus forced into the cavity of the mould.

4. The wax pattern thus produced is removed from the mould by separating the half sections of the mould. It is then invested in plaster of paris which will form a suitable mould for the metal which it is ultimately desired to form to that shape.

5. The investing material may be dried out in any suitable manner but in any event the mould created by

the plaster of paris is subjected to sufficient heat to melt the wax and all traces of this wax are completely removed from the mould.

6. The cavity within the plaster mould conforms to the wax pattern. The mould (investment) is then placed in a centrifugal casting machine and the molten metal from which the casting is to be made is poured into this mould and is projected by the applied force of the centrifugal action into the fine recesses. The mould is then broken up and the metal replica of the original model is abstracted.

The process thus described is a refinement of the ancient "cire perdue" or the "lost wax" process. In brief it calls for two castings for the production of a metal replica of a model. First, a wax casting is produced which in turn is used to form a mould suitable for metal casting; second, a metal casting is formed with the aid of the final mould.

There is no dispute concerning the methods pursued by the defendants and intervenors in the manufacture of rings. All use the several steps of the process with the following variations: For the primary mould some use soft metal moulds as well as rubber moulds. To inject the wax into the primary mould all use a centrifuge and some also use an eye dropper or syringe, air gun, air injection machine, hydraulic machine and vacuum casting machine. All have produced and sold articles of jewelry made by the process. At least to the extent that defendants have used centrifugal force to deposit the wax into a primary rubber mould, and all have, there can be no question that they have infringed.[1]

[1] So much defendants concede. They deny, however, any infringement in the use of metal moulds and in the use of any means other than centrifugal force for the injection of the wax into the primary mould.

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Opinion

The issue of validity is thus reached immediately.

At or about the time the plaintiff contrived his process, December, 1933, the jewelry manufacturing industry generally used one of four methods for the fabrication of rings.[2]

1. Handcraft by skilled artisans.

2. Cuttlefish casting, which consists of compressing the model of the ring to be reproduced between two loaves of cuttlefish bone. The yielding surfaces of the bone form a cavity roughly corresponding to the form of the compressed model. A channel or opening between the two loaves permits the molten gold to flow into this cavity, to form a rough replica of the model. This casting is then hand-finished.

3. Sand casting, which consists of imbedding the model in a sand frame which, upon the removal of the model, leaves a cavity into which the molten metal is admitted by an opening provided for the purpose. Its advantage over cuttlefish casting is that it permits the production of six to twelve castings from a single mould. The casting is rough and requires hand finishing.

4. Die stamping, which consists of stamping out the ring or parts of it by means of metal dies. This process is very efficient. It is still in extensive use when numerous castings of a single design are desired. Its initial cost is high. The dies for a single ring-design cost from $250 to $2,000.

Today cuttlefish casting and sand casting are of little commercial significance. Die stamping and the "lost wax" process are pre-eminent in the production of rings.

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[2] The evidence was substantially all addressed to the formation of rings although the patent is not so limited.

The evidence clearly supports a finding that, after Jungersen, the lost wax process as refined by him has been extensively employed in the manufacture of rings; and I shall therefore attribute to the patent "commercial success."

This, however, does not foreclose consideration of the issue of invention; nor does it render dispensable inspection of the prior art. Defendants rely upon seven items to prove that the patented process is old. In chronological order these are:

1. The Treatises of Benvenuta Cellini, 16th Century.
2. Haseltine, British Patent No. 2467, issued 1875.
3. Spencer, U. S. Patent No. 748,996, issued 1904.
4. Kralund, U. S. Patent No. 1,238,789, issued 1917.
5. La Gravure, Publication, 1926.
6. Slatis-Dee, use and sale of product, 1931.
7. Austenal, use, 1932.

Cellini describes in minute detail the "cire perdue" or lost wax process as applied to the casting in bronze of figures of life size or under. The features which distinguish it from the patented process are that Cellini does not use a rubber mould but one made of "Gesso," that is, plaster of paris or gypsum; he pours his wax, apparently employing no force but gravity to fill his mould; and when the wax is melted out, he allows the molten bronze to flow into its place, again without the use of pressure.

Plaintiff, of course, calls attention especially to Cellini's method of pouring the wax as differentiating it from the patented process. He also argues that Cellini's method was available only to the artist and not to the artisan because Cellini suggests that after the wax form has

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been prepared, "if you are minded to add any subtle labour or fancy to your work, you are easily able to do it." This last suggestion, however, does not diminish the value of the disclosure to those who are not minded to add "any subtle labour or fancy." Finally, plaintiff argues that Cellini's publication is not part of the relevant prior art because it pertains to the non-analogous sculptural art. Consideration of this point is deferred since it is also addressed to some other prior art citations.

Haseltine's invention has as its object the production of a metal casting which is a perfect copy of its model. He teaches the making of a thin rubber mould about the model, into which mould, when freed from the model, he pours melted wax. To help the thin rubber retain its shape, he suggests its suspension in water. The wax model is invested with clay, after which the wax is melted out of the clay mould. He suggests that ordinary pouring of the metal into the clay mould will not give clear definition of lines and therefore recommends that the metal be poured through a pipe from a sufficient height so as to produce the required pressure. Illustratively he speaks of a statute and in his drawing he shows a vase.

Spencer's patent is for a flexible mould for intricate designs. Neither with respect to wax nor metal does he teach the use of force or pressure for the injection into the mould.

It should be noted that of these references only Haseltine and Spencer were before the Patent Office.

Kralund is concerned with commercial castings, especially but not exclusively, of large bulk. He teaches the use of the "cire perdue" process with the addition of pressure derived from a die casting apparatus for the introduction of the wax into the die and for the introduction of the metal into the final mould.

His primary mould is of metal machined to its desired shape. Plaintiff distinguishes Kralund: The disclosure

is in the field of commercial casting; Kralund's purpose was to preserve expensive steel dies by using them to cast wax patterns instead of stamping the finished metal product; if the jeweler had Kralund's dies he would stamp his rings, not cast them. While it is unquestionably true that Kralund was directing his efforts toward the more exacting requirements of precision tool casting, it does not follow that his disclosures can be dismissed as inapplicable. Clearly both plaintiff and defendant agree that by 1933 metal and rubber primary moulds were interchangeable and equivalent.

La Gravure adds little to the "cire perdue" process, except that it is explicitly applied to small pieces of jewelry. It does not teach the use of pressure in the wax casting stage but does suggest the use of steam pressure in the metal casting stage.

The Slatis-Dee method is identical with Jungersen's. However, defendants agree that it did not anticipate because it was secret. (See, however, *Dow Chemical Co.* v. *Halliburton Co.*, 1945, 324 U. S. 320, 326.) But defendants do rely upon a ring made by Slatis in 1931 and worn for some time by Radix, president of the Dee Company, as anticipating Claim 6. A customer of the Dee Company testified that he bought one cast ring which was not satisfactory. I am not inclined to give much weight to the Slatis-Dee either as anticipation of the process or as anticipation of the product.

The Barbed Wire Patent, 1892, 143 U. S. 275, 284.

Austenal: Great reliance is laid by defendants on the Austenal prior use. During 1932-1933, the Austenal Laboratories in Chicago, developed a method of reproducing "Steele's Backings" for the dental trade. A Steele's backing is a small undercut metal rail which fits into a channel of an artificial tooth and is used to secure the tooth to the dental plate. The process employed was

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identical with Jungersen's except for the use of an eye-dropper to squirt the wax into the rubber mould in place of a centrifugal machine. For casting the metal Austenal employed a centrifugal machine or air pressure. I read the testimony on the Austenal use[3] to show the employment of an eye-dropper or syringe for the introduction of the wax but (though a syringe is capable of generating force) not for the purpose of applying force, and without the effect of pressure. The process met with only moderate success, was used for about a year and then superseded by a superior process.

Especially instructive is Jungersen's own testimony concerning his invention because it throws light on what he regarded as available art when he first undertook to make a casting of a ring. He testified that he had been a consulting engineer and manufacturer of gasoline and diesel engines and pumps. While sojourning in Canada, in 1933, he made a wager with a friend that he could take any job his friend would select out of the newspaper advertisements. He applied for employment with a jeweler who was looking for a caster in sand and offered to reproduce any model the jeweler assigned to him. He received a model of a ring. On his way home he bought some patching rubber at a gasoline station. At home he prepared a wooden frame in which he vulcanized a rubber mould about the model. "I had quite a little trouble filling the mould with wax. I knew that the dentists were using wax patters * * * and finally I fell on the idea of filling by centrifugal force * * * I made a swing out of a wired clothes-hanger that I could swing around in my hand * * * and after that * * * I went to a mechanical dentist" where he made his final casting by means of a centrifugal machine. Only later did he hear that he had done something unusual.

---

[3] The record of another trial was received by stipulation.

In his British application, filed September 1934, for "improvements in methods and means of casting metals" plaintiff stated,

> "In the casting of metal it is not broadly new to make an elastic mould from an original sample or model, to produce a wax or fusible pattern with the aid of the elastic mould and to remove the pattern from the latter and invest it in a final mould from which the wax or fusible pattern is subsequently melted out to permit the pouring of the metal into the mould cavity thus vacated."

Thus we have in substance the prior art available to Jungersen when he devised his process. The question is whether his teaching amounts to invention.

Before evaluating the advance made by him, note should be taken of three district court adjudications of the very patent in issue. The first in *Jungersen* v. *Jenkins*, D. C. Maryland, 1939, 30 Fed. Supp. 615. The case was "*really undefended.*" The court emphasized the use of centrifugal force for the injection of both the wax and the metal, the view that the prior patents related to "non-analogous arts such as the sculptors' art and the dental and foundry arts," and commercial success. The court found all claims of the patent valid.

The second is *Jungersen vs. Morris Kaysen Co.*, E. D. Pa., 1940, 31 Fed. Supp. 703. The court found all claims valid. It emphasized the novelty of the use of centrifugal or similar force for the introduction of the wax into the primary mould and the commercial success of the process. It relied on *Bristol vs. Otis Elevator Co.*, C. C. A. 3, 1931, 52 Fed. 2d 772, 773, which held,

> "To anticipate a combination, the combination in its entirety must be old."

The last of the cases is *Ostby & Barton Co. vs. Jungersen*, D. C. N. J., 146, 65 Fed. Supp. 652. Plaintiff sought a declaratory judgment of invalidity and non-infringement. The court found that the patent described a combination of old elements to which a new one had been added, to wit, the use of centrifugal force for the injection of the wax into the primary mould. Relying upon *Textile Machine Works vs. Louis Hirsch Textile Machines, Inc.*, 1938, 302 U. S. 490, 497, it held that in order to validate the patent the addition must be the result of invention rather than the mere exercise of the skill of the calling. It found such invention. The prior knowledge, it said, was in the field of "non-analogous casting arts. The end results required in those arts were dissimilar to those in the jewelry art." It held that, if there were any doubt, it was dissipated by the commercial success of the process. The court found claims 1 to 4 valid. However, it found claims 5 and 6 invalid and cited the Kralund patent as an anticipation, although Kralund addressed himself to commercial castings. Claims 5 and 6 do not specify the use of centrifugal force. Claim 5 speaks only of introducing the wax into a primary mould by "force sufficient to deposit the material" and not injure the primary mould. Kralund, too, had taught making the wax pattern by "forcing molten material having a low fusing point into a metal mould or die under sufficient pressure to insure the filling of said mold or die."[4]

[4] In the Ostby & Barton case there was no claim and no finding of infringement of claims 1 to 4. Query whether weight is to be given to the finding of validity of these claims in view of *Cover v. Schwartz*, C. C. A. 2, 1942, 133 Fed. 2d 541, 544, cert. den. 319 U. S. 748, reh. den. 319 U. S. 785; *Addressograph-Multigraph Corp. v. Cooper*, C. C. A. 2, 1946, 156 Fed. 2d 483, 485; *Brunswick-Balke-Collender Co. v. American Bowling & Billiard Corp.*, C. C. A. 2, 1945, 150 Fed. 2d 69, 70, cert. den. 226 U. S. 757; *Sinclair & Carroll Co., Inc. v. Interchemical Corp.*, 1945, 325 U. S. 327, 330.

Opinion

The novel feature of the Jungersen process relates to the casting of the primary pattern in wax or other fusible material. He injects the wax into the primary mould by centrifugal force. Does that constitute invention? Clearly the use of force for casting the metal is old; Haseltine, La Gravure, and Kralund taught it. The need of force for casting the wax was taught by Kralund who used a die casting machine. Moreover, by his claim of infringement plaintiff practically concedes the equivalence of the several modes for the application of force, namely, syringes, air pressure and centrifugal machines. The centrifugal casting machine was described in U. S. patent No. 1,457,040, issued to McManus in 1923, and was expressly stated to be suitable for the casting of jewelry such as rings "where moulds may be used to be filled by centrifugal casting methods."

In brief, the lost wax process is very old.[5] The use of force, including centrifugal force, in filling the final mould is old. If the general casting art is the critical art for the patent in issue, I would have no hesitation in holding that the substitution of centrifugal force for other means of casting the wax is not invention, but the application of an equivalent means.

---

[5] A brochure published by Banco de la Republica, Bogota, Colombia, 1944, shows ancient gold statuettes, of native origin, attributed to the "lost wax" process.

Pal Kelemen, Medieval American Art (The MacMillan Co., New York, 1944), Vol. I, p. 241: "The *cire perdue*, or 'lost wax' process of casting was widely employed [by the Peruvian goldsmiths around the 10th century]. This method was essentially the same as that used for our bronzes today. It was known also in ancient Egypt and the Near East, then apparently lost to Europe in the first centuries of Christianity to be re-invented for the Renaissance shortly before Benvenuto Cellini. The perfection of this process in pre-Columbian America serves as a striking example of parallel development, when similar conditions produce similar results."

Opinion

Once the use of force for the introduction of the wax into the mould was known to be desirable—and Kralund showed it—the choice of alternative means for the application of force became a non-inventive application of the skill of the caster's art. To put it simply, in the casting art it was old knowledge that the forced introduction of molten material into a mould produced greater definition of line and contour and greater fidelity of reproduction. McManus' patent showed the use of a centrifugal machine as the source of force for such purpose, which lent itself especially to small castings. Were it at that time desired to make faithful wax castings, as the final article of manufacture, it would not amount to invention to introduce the wax into the mould by centrifugal force. I fail to see why it rises to the level of invention when casting the wax pattern is an intermediate step in a longer process.

It is argued, however, that jewelry casting is non-analogous to the prior art. This argument cannot carry much weight. The art of photography has been held to be analogous to the art of blueprinting.

> *Elliott & Co.* v. *Youngstown Car Mfg. Co.*, C. C. A. 3, 1910, 181 Fed. 345.

Clay cutting has been held analogous to dough cutting.

> *J. H. Day Co.* v. *Mountain City Co.*, C. C. A., 6, 264 Fed. 963.

The woodworking art and metal working art have been held analogous.

> *Ball & Roller Bearing Co.* v. *Sanford Mfg. Co.*, D. C. Conn., 1922, 280 Fed. 415, rev., C. C. A. 2, 1924, 297 Fed. 163, but see p. 165.

See,

> *Walker on Patents*, Deller's Ed., 1937, p. 226.

In the light of such precedents it is hard to justify a view that the casting of vases, statuettes, and small precision parts for tools is not analogous to the casting of rings. Perhaps such a view could be maintained if the casting art were transferred to a purpose never associated with a casting, such as, if rings had never been made by the casting process. But casting of rings by cuttlefish or sand mould is old art.

The evidence does not justify a finding that there is a distinct jeweler's art. The only substantial evidence on the subject was that the casting of jewelry was part of the casting art. *A priori*, I should suppose that when a jeweler engraves a ring, he employes the engraver's art, when he casts a ring, he employs the casting art. All that has been established is that jewelers did not use the "lost wax" method of casting. That tradition, habit and lack of economic pressure in the manufacture of a relatively costly article combine to close the eyes of a trade to available improvement does not elevate the adoption of the improvement to the rank of invention.

Moreover, it is clear beyond peradventure that Jungersen did not believe himself engaged in a non-analogous art. The opening paragraph of the patent, which has already been quoted, is quite instructive on that. Jungersen addresses himself to the casting of small metal articles:

> "In carrying this invention into effect the designer of a piece of jewelry or any small article to be cast";

also, the following,

> "It will be understood that this process is particularly applicable to the casting of precious metals, but it will also be understood that various other metals may be handled in the same way and particularly, base metals of tin and similar alloys."

The caption of the patent is

"Method of casting articles of intricate design and a product thereof,"

clearly bringing it within the casting art. Cellini was undoubtedly a sculptor, but I doubt the jewelers would have regarded him as an intruder in their midst.[6]

The conclusion I reach is that the claims are all invalid because anticipated and for want of invention. Claim 6 is also invalid because it describes an old article in terms of a process of manufacture.

Cochrane v. *Badische Anilin & Soda Fabrik*, 1884, 111 U. S. 293, 311;
Pfantiehl Chemical Co. v. *American Platinum Works*, C. C. A. 3, 1943, 135 Fed. 2d 171, 173.

Dated, New York, N. Y. February 7, 1947.

SIMON H. RIFKIND
U. S. D. J.

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[6] Cellini's first apprenticeship was to a goldsmith. At Rome he was employed on jewelry. Is his celebrated saltcellar in the sculptor's or the jeweler's art?

Exhibit C.

(137) * * * * *

The Witness: That would be the second paragraph, would it not, Mr. Groner?

(Witness hands paper to Mr. Groner.)

Mr. Groner: The paragraph to which the witness has referred in part relates to certain defenses in the Baden & Foss case. As to those, privilege is claimed. The letter goes on to say—and I do not read this statement completely because some of it again goes to the defenses—:

> "The work entailed a great deal more time and expense"—I am deleting certain parts—"than was originally contemplated, and as a result the sum of $5,000 heretofore remitted to said law firm"—that is, Fish, Richardson & Neave—"has been used up, despite the fact that Ostby & Barton bore a substantial portion of such expense."

Q. Mr. Axel, do you have any other papers among the group of papers which you have not produced? A. That is all.

Q. Have you looked? A. Yes, and that is all.

Q. Will you take out the letter from which your counsel just read and tell me whether it is a ribbon copy or a carbon copy, if you can, and how it is signed; that is, whether it is typewritten? A. No, it is a signature by Hugo J. Frankl.

Q. And does the body of it appear to be a copy rather than a ribbon original? A. It is not an original.

* * * * *

Exhibit D.

UNITED STATES COURT OF APPEALS

FOR THE SECOND CIRCUIT

No. 65, October Term, 1954.

Argued December 10, 1954 Decided December 20, 1954

Docket No. 23162

THOGER GRONBORG JUNGERSEN,
Plaintiff-Appellant,

v.

AXEL BROS., INC., et al.,
Defendants-Appellees.

Before CLARK, Chief Judge, and MEDINA and HARLAN, Circuit Judges.

Appeal from the United States District Court for the Southern District of New York, Sylvester J. Ryan, Judge.

Plaintiff, Thoger Gronborg Jungersen, appeals from a summary judgment dismissing his complaint to vacate and set aside, for fraud, the judgment in *Jungersen* v. *Baden*, D. C. S. D. N. Y., 69 F. Supp. 922, affirmed 2 Cir., 166 F. 2d 807, affirmed 335 U. S. 560, holding invalid his patent No. 2,118,468 as issued by the United States Patent Office.

Elliott L. Biskind, New York City (Arthur J. Brothers, New York City, on the brief), for plaintiff-appellant.

John Vaughan Groner, New York City (William K. Kerr, New York City, on the brief), for defendants-appellees.

PER CURIAM.

Affirmed on the opinion of District Judge Ryan, D. C. S. D. N. Y., 121 F. Supp. 712.

Exhibit E.

UNITED STATES COURT OF APPEALS
FOR THE
SECOND CIRCUIT

At a Stated Term of the United States Court of Appeals, in and for the Second Circuit, held at the United States Courthouse in the City of New York, on the 20th day of December one thousand nine hundred and fifty-four.

Present: HON. CHARLES E. CLARK,
Chief Judge,

HON. HAROLD R. MEDINA,
HON. JOHN M. HARLAN,
Circuit Judges.

THOGER GRONBORG JUNGERSEN,
Plaintiff-Appellant,

v.

AXEL BROS., INC., A. BLUMSTEIN, INC., FEATURE RING CO., INC., O. M. RESEN, INC., et al.,
Defendants-Appellees,

HARRY COHAN, et al.,
Defendants.

Appeal from the United States District Court for the Southern District of New York.

This cause came on to be heard on the transcript of record from the United States District Court for the Southern District of New York, and was argued by counsel.

ON CONSIDERATION WHEREOF, it is now hereby ordered, adjudged, and decreed that the judgment of said District Court be and it hereby is affirmed.

It is further ordered that a Mandate issue to the said District Court in accordance with this decree.

A. DANIEL FUSARO, Clerk.

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Exhibit F.

UNITED STATES COURT OF APPEALS
SECOND CIRCUIT
United States Courthouse
Foley Square
NEW YORK 7

A. Daniel Fusaro
Clerk

January 14, 1955

THOGER GRONBERG JUNGERSEN
Plaintiff-Appellant

vs.

AXEL BROS. INC., A. BLUMSTEIN, INC., FEATURE BING CO., INC., O. M. RESEN INC. et al
Defendants-Appellees.

Dear Sirs:

The Court has today handed down a decision in the above-entitled cause on petition for rehearing. See below for decision.

Very truly yours,

A. DANIEL FUSARO, Clerk.

"Petition denied

C.E.C.
H.R.M.
J.M.H.
U.S.C. J.J."

FILED
MAY 4 1955
HAROLD B. WILLEY, CL

IN THE

Supreme Court of the United States

No. 712

THOGER GRONBORG JUNGERSEN,

Petitioner,

against

AXEL BROS., INC., A. BLUMSTEIN, INC., FEATURE RING CO., INC., O. M. RESEN, INC., HARRY ROSENBERG CO., INC., ROTHMAN & SCHNEIDER, INC., SKALET MFG. COMPANY, INC., ROBERT BADEN, GLADYS FOSS, HARRY BERLAND, SEYMOUR BERLAND, SHERLE BERLAND, JEAN BERLAND, JACOB FLYER, HERMAN FLYER, DAVID KLEBANOFF, SAM GROSSMAN, ARTHUR CELONA and SAM TOUR,

Respondents,

and

HARRY COHAN, MAX COHAN, DAVID SELIKOFF, LOUIS WITKIN, ALBERT FOSS, ANNIE BERLAND, LOUIS DOLGOV and ROSE BADEN,

Defendants.

PETITIONER'S REPLY BRIEF

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New York 38, N. Y.

ARTHUR J. BROTHERS,
Of Counsel for Petitioner,
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IN THE

Supreme Court of the United States

No. .....

THOGER GRONBORG JUNGERSEN,

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Respondents,

and

HARRY COHAN, MAX COHAN, DAVID SELIKOFF, LOUIS WITKIN, ALBERT FOSS, ANNIE BERLAND, LOUIS DOLGOV and ROSE BADEN,

Defendants.

PETITIONER'S REPLY BRIEF

There is no disposition on the part of petitioner to belabor the points made in his petition; nor does petitioner wish to quibble on comparatively minor details.

This reply brief will be restricted to a short discussion of one or two observations made in respondents' brief which petitioner regards as dealing with essential matters.

The Affidavits

On page 3 of respondents' brief, the point is made that petitioner's answering affidavits on the motion for summary judgment do not indicate that the statements made therein were made on personal knowledge. Nowhere in respondents' supporting affidavits, is there any denial of fraud by those specifically and directly charged therewith. The complaint does not charge respondents' attorney with the fraud, but charges the defendants' themselves and Ostby & Barton Company. The papers in support of the motion for summary judgment are devoid of an affidavit by Sam Tour, by an officer of Ostby & Barton Company and by any one else charged with fraud.

Tour

On page 4 of respondents' brief is the statement that "with a single exception" Tour testified, in the *Baden* case, precisely as he had testified in the *Ostby & Barton* case in New Jersey. However, while Tour's testimony in the *Baden* case is set out as the "single exception", his testimony on the same point in the *Ostby & Barton* case is not given. In the latter case, Tour testified that during the 8 years he was with the Doehler Company he was "directly in the production end in connection with pressure die casting, in connection with plaster mold casting" and also with "some lost replica or lost wax process casting."*

In the *Baden* case Tour testified differently, namely, in referring to his work at the Doehler Company, that "I, as a metallurgist, was not a production worker, so naturally what I did in that type of work was experimental upon my part, because I was not a production employee in any casting department, whereas Mr. Kralund was plant superintendent at the time" (154; 461).

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* Page 146 A, folio 436, Ostby & Barton Company v. Jungersen, Transcript of Record, 335 U. S. 560.

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Pack Affidavit

With respect to the Pack affidavit discussed on pages 5 and 6 of respondents' brief, the statement is made that in the second Pack affidavit Pack "admitted" that Kralund and Tour had "worked together" at Doehler. What the second Pack affidavit actually says (103; 307 to 309) is as follows:

> "Mr. Kralund and Mr. Sam Tour undoubtedly were acquainted and they did work in the same plant at the same time".

Then the Pack affidavit states that Tour's "assigned" duties at Doehler may have been "somewhat broader" than those stated in the first Pack affidavit. The first affidavit states (97; 289) that at no time since the Kralund patent had been abandoned did Mr. Kralund do any experimental work at the Doehler Company on wax castings and that at no time was Mr. Tour under the direction of Mr. Kralund nor did he at any time collaborate with Mr. Kralund on any research or experimental work. Mr. Pack's second affidavit, which states that Mr. Tour's "assigned" duties may have been "somewhat broader", refers to his assigned duties as a metallurgist (97; 290). The second affidavit does not in any sense change or weaken Mr. Pack's original statements that Tour had nothing to do with the Kralund patent, either experimentally or in production. His statement in the second affidavit that Kralund and Tour might have "talked" of the process cannot justify the statement in respondents' brief, on page 5, that Kralund and Tour "worked together" at Doehler.

Respondents claim they had no chance to cross-examine Mr. Pack. If they really desire such opportunity, they may have it on a trial. Their motion for summary judgment is inconsistent with their claimed desire to do so.

Equity

Petitioner did not institute this action to relitigate the validity of his patent. He instituted the action because of a rule of law, basic to our jurisprudence, that a party who seeks the court's aid in equity must be open and above-board in his dealings with the court, and that if in the course of seeking that aid a party abuses the court's confidence, presents planned perjurious testimony, such a party may neither receive aid from the court of equity nor retain aid previously received. That is the reason the statement is made in the petition at pages 37 and 41 that petitioner is not concerned with the validity of the patent at this time and that speculation upon relitigation of the issue of patent validity has no place in this type of action.

Respondents' brief denies none of the accusations of fraud, nor, for that matter, did any of respondents' affidavits on summary judgment. Respondents' brief restricts itself to a tacit admission of the existence of the fraud, but claims that even without the fraud, the judgment of invalidity would have been warranted. Its position that the fraud was immaterial to the original judgment of invalidity cannot defeat petitioner, nor can it justify the fraud practiced upon the court.

Hazel Case

Respondents' discussion of the *Hazel* case misses the point. The *Hazel* case did not involve perjurious sworn testimony planned and given in the course of a trial. It involved merely a substantially factually true article attributed to a false author. The Circuit Court in that case said what respondents now say, that even without the article their decision would have been the same. This Court said, in effect, that that is no criterion; that since

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Hartford, in the *Hazel* case, thought the article material, it is in no position to dispute its effectiveness. In this case the defendants thought Tour's testimony was material and, as we have seen, it actually was so. They, also, are in no position to dispute its effectiveness. In the *Hazel* case this Court found a "deliberately planned and carefully executed scheme to defraud not only the patent office, but the Circut Court of Appeals". In this case we find a deliberately planned and carefully executed scheme to defraud the United States District Court.

Conclusion

Respondents' request to this Court to deny certiorari is in effect a request to protect them against exposure and the inevitable results of exposure. Their opposition to this petition is in effect a request for an endorsement of planned perjury and fraud as a method of misguiding and imposing upon our courts. If the respondents are guilty of no such reprehensible activity, they should be the first to insist upon a full and fair trial of the issues, in order that whatever taint attaches to their activity may be removed. Instead of adopting that procedure, they say to the Court that while we may have imposed upon you through the presentation of fraudulent testimony, you did not rely upon that fraudulent testimony and therefore we should be absolved of any wrongdoing. Such a novel and amazing request should be dealt with in the only manner open to this Court, namely, granting petitioner's Writ of Certiorari.

Respectfully sumbitted,

Elliott L. Biskind,
Attorney for Petitioner,
160 Broadway,
New York, 38, N. Y.

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APR 28 1955
HAROLD B. WILLEY, CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1954

No. 712

THOGER GRONBORG JUNGERSEN,
Petitioner,

against

AXEL BROS., INC., *et al.*,
Respondents,

and

HARRY COHAN, *et al.*,
Defendants.

BRIEF FOR RESPONDENTS IN OPPOSITION

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Of Counsel

Dated New York, N. Y.
April 26, 1955.

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CITATIONS

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IN THE

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OCTOBER TERM, 1954

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Defendants.

No. 712

BRIEF FOR RESPONDENTS IN OPPOSITION

Opinions Below

The opinion of the District Court for the Southern District of New York (R., fs.* 550-584) is reported in 121 F.

* References to the Record in this case will be to the folio rather than the page numbers in order more exactly to pinpoint the cited matter, thus "R., f. ——". References to the record in *Jungersen v. Baden, et al.*, No. 48, October Term, 1948, will be to "*Baden*, p. ——". Jungersen's petition here will be referred to as Peto., p. ——".

Italics and parentheses within quotes are ours throughout, unless the contrary is indicated.

Supp. 712. The Court of Appeals for the Second Circuit affirmed, *per curiam* (Peto., p. 67, Ex. D).

Jurisdiction

Petitioner invokes the jurisdiction of this Court under 28 U. S. C. A. Rule 60(b).

The jurisdiction of this Court is founded on 28 U. S. C. §1254(1).

Rules and Statutes Involved

Rule 56, Rules of Civil Procedure

(c) . . . The judgment sought shall be rendered forthwith if the pleadings, depositions, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law. . . .

(e) Form of Affidavits; Further Testimony. Supporting and opposing affidavits shall be made on personal knowledge, shall set forth such facts as would be admissible in evidence, and shall show affirmatively that the affiant is competent to testify to the matters stated therein . . .

Statement

This action sought to set aside, for alleged fraud, a judgment of the District Court for the Southern District of New York in *Jungersen* v. *Baden, et al.* The judgment in that case, rendered April 22, 1947, had held Jungersen patent No. 2118468 invalid.

Defendants here moved for summary judgment (R., fs. 31-32) and that motion was granted (R., fs. 586-588), the rationale of the District Court's decision being expressed in the following statement (R., f. 579; 121 F. Supp. 717):

> "From an analysis of the alleged perjurious testimony and of the decisions herein it is apparent that

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> the findings and opinions of the District Court, the Court of Appeals and the Supreme Court were based entirely on grounds independent of matters with which defendants Tour and Baden's testimony was concerned. No manifest injustice can result from the enforcement of a judgment of invalidity which was based on unchallenged matter."

The decision of the District Court in the earlier infringement case, the *Baden* case (R., fs. 131-174), is reported in 69 F. Supp. 922. After full hearing, it was affirmed by the Court of Appeals for the Second Circuit (R., fs. 175-210, and 166 F. 2d 807), and then by this Court (R., fs. 211-250, and 335 U. S. 560).

Jungersen's petition here states that "The ground for seeking to set aside the judgment [in the *Baden* case] is fraud practiced upon petitioner and the trial court, in the form of prearranged false testimony by the defendants' sole expert witness and others, which was intended to and did mislead the court by a false showing of want of invention" (Peto., p. 3).

In the District Court, in the instant action, Jungersen's case rested, substantially entirely, on two affidavits filed by him (R., fs. 463-503 and 514-537). These affidavits make little pretense of being "made on personal knowledge", and, in the overwhelming majority of cases, they certainly do not "set forth such facts as would be admissible in evidence" or "show affirmatively that the affiant is competent to testify to the matters stated therein", as required by Rule 56(e).

Briefly summarized in the words of Jungersen's petition here, Jungersen asserts that defendants' expert, Sam Tour, "testified, with respect to a prior patent, called the Kralund patent [Kralund No. 1238789, one of the prior patents relied on by the *Baden* defendants] that he had worked with Kralund on the process, that the Kralund patent preceded and was substantially the same as Jungersen's, could do the same things and make the same articles, and that it

was a practical, operative, commercially successful method of precision casting used in production at the Doehler Die Casting Company", and that "Tour was presented as a witness with no interest in the outcome of the action, whereas in fact, he was then employed by Ostby & Barton Company . . ." (Peto., p. 6).

The last facet of these charges is frivolous and without consequence. Tour was presented as an expert in the casting art. (*Baden,* pp. 147-150); his prior connection with Ostby & Barton was well known (*Baden,* p. 167); his testimony in *Jungersen* v. *Ostby & Barton, et al.,* and in the *Baden* case was to "the same effect" (R., f. 416; *Baden,* p. 167) and, in the *Baden* case, he wasn't even asked as to his obvious relationship with Ostby & Barton (*Baden,* pp. 167-171, 181-182).

Therefore, the only remaining part of Jungersen's charges is that concerned with Kralund and Doehler. And, in order to bring it into focus—and, at the same time, demonstrate its entire lack of substance—some background must be given.

At the hearing in the *Baden* case, the *sole* defense was that the Jungersen patent was invalid in view of seven prior patents or publications.* Tour, of course, testified with respect to the disclosures of this prior art. Jungersen's petition, here, quotes the great bulk of this testimony (Peto., pp. 7-23). With a single exception, Tour's testimony is simply a paraphrase of what is written on the face of those patents or publications, and its accuracy has not been and cannot be challenged.

The sole exception is found in his testimony that, more than twenty years earlier, he had known John Kralund and had worked with him at Doehler; that he had done some *experimental* work with him "in connection with this

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* Originally, two prior uses were urged but neither was upheld (Findings 13 and 16, R., fs. 265-267) and both were abandoned before appeal.

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particular [Kralund] method" (R., f. 425; *Baden,* p. 154), and that the Kralund method was a practical and operative one which "has been applied very extensively during *this war* [i.e., World War II] to the casting of millions of small articles" (R., fs. 426-428; *Baden,* pp. 153-156).

Though this testimony, of course, had been under oath and Tour had been subjected to cross-examination (*Baden,* pp. 167-171, 181-182), Jungersen challenges it solely on the basis of an affidavit executed October 19, 1948, by one Charles Pack (R., fs. 277-291). And Pack, *not subject to cross-examination,* dictated his affidavit, according to Jungersen, *"from memory"* (R., f. 500). So far as pertinent, it stated that Kralund did no experimental work "on wax castings" after 1915 and that "Mr. Tour at no time was under the direction of Mr. J. Kralund, nor did he at any time collaborate with Mr. Kralund on any research or experimental work" (R., fs. 289, 291).

While Jungersen must have talked to Pack at least as early as the general period of the District Court decision in the *Baden* case, that is, around April 1947 (see Compl., Para. Seventeenth, R., f. 25), the Pack charges became known to the Baden defendants only the day before the *Baden* case was argued in this Court in November 1948 (see Jungersen's Reply Brief in *Jungersen* v. *Ostby & Barton, et al.,* p. 4, fn.; R., f. 276). Immediately thereafter, Pack was approached and, having had an opportunity to refresh his recollection by the examination of various records, papers, etc., gave a second affidavit (R., fs. 304-309), which showed that his "memory"—the sole basis for his first affidavit—had been as fallible as memory often is. In this second affidavit Pack admitted that Kralund and Tour had worked together at Doehler; that Tour's work there "may have been somewhat broader" than his assigned duties—and thus may have included research or experimental work with Kralund; and that he did not mean to imply by his earlier affidavit "that Mr. Kralund and Mr. Tour could not have talked of said Kralund process or of experimental

work in connection therewith, because as to this [he had] no knowledge" (R., fs. 308-309).

In the light of the second Pack affidavit, the entirely unreliable nature of the first Pack affidavit is manifest. And in asking this Court to grant his Petition, which finds its sole substantiation in Pack's first affidavit, Jungersen asks this Court to consider that affidavit *for the third time.* For, following this Court's decision in the *Baden* case, Jungersen, on January 27, 1949, appearing *pro se,* filed a "Motion for Leave to File Petition for Reconsideration" (R., fs. 313-363), which relied largely on that affidavit and apparently other material (R., f. 322). Jungersen's motion was denied on February 14, 1949 (336 U. S. 915) and on February 25, 1949, Jungersen filed in this Court a further "Petition for Reconsideration" (R., fs. 364-386), which, *inter alia,* contained the statement that "If furnishing proof of the testimony in the case being false or misleading is not grounds for at least having the case reconsidered then it seems that justice is a meaningless word" (R., f. 368). Notwithstanding this, on March 14, 1949, this petition also was denied (336 U. S. 932). The charges made in Jungersen's motion and his petition are substantially the same as those in the complaint here (R., fs. 324-340, 368-369, 382-384).

The present action is simply another attempt, long after the event, to relitigate a matter which has never had substance, which has been finally determined against Jungersen and which in any event has been stale for more than five years.

Argument

The petition (Peto., p. 2) poses two questions, viz.:

Was it error, in a case like the instant one, to accept the allegations of perjury and its subornation but to dismiss the suit on the ground that, even if perjury existed, it was neither material nor relevant to the grounds upon which the earlier judgment was rendered; and

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Is the decision of the District Court and, by adoption, that of the Court of Appeals in this case, in conflict with applicable decisions of this Court?

Even if it be assumed, contrary to the fact, that perjury had been committed, as alleged, it is clear that a fraud *in vacuo* and without effect is of no consequence and will be disregarded. Similarly, it is clear that the decisions below are in full accord with all applicable decisions of this Court.

Fraud, If Any, Was Immaterial

The record here clearly shows there has been no fraud. The complaint and the supporting affidavits of Jungersen are simply empty charges* which are entirely unsupported by anything which might raise a "genuine issue as to any material fact" as required by Rule 56(c).

Beyond this, the complaint and the affidavits relate to matter which is utterly inconsequential to any of the decisions in the earlier litigation. As indicated earlier, the defenses in that litigation were based solely on prior patents or prior publications. And so, too, are the three decisions in the *Baden* case, as analysis of them unanswerably demonstrates.

The decision of the District Court (R., fs. 131-174) outlines in detail the disclosures of the various prior references (R., fs. 149-157), Jungersen's own testimony as

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* Large parts of the Jungersen affidavits are purely argumentative (R., fs. 464-467, 469-474, 478-480, 492-503, 515-537). Other parts, such as his difficulties with the Internal Revenue Bureau and certain alleged occurrences in Los Angeles, which admittedly had no part in the *Baden* case (R., fs., 477-478, 489-490), are utterly irrelevant. And in a number of cases the petition here relies on asserted facts which aren't even in this record (see Peto., pp. 6, 27, 31 regarding the asserted loss of busines of Ostby & Barton; Peto., p. 32 regarding Met-Chem Corporation and its asserted fees or commissions; and Peto., pp. 20-21 regarding the asserted action of the War Production Board *in 1946*, which, in view of the issue of the Jungersen patent *in 1939*, is ridiculous).

to his alleged invention (R., fs. 158-159), and notes particularly the admissions contained in his British patent, which corresponded to the patent in suit (R., fs. 159-160). And, on the basis of these facts, it concluded that

> "The novel feature of the Jungersen process relates to the casting of the primary pattern in wax or other fusible material. He injects the wax into the primary mould by centrifugal force" (R., f. 165).

But, the Court showed that the use of force for the casting of metal was old and that the Kralund patent used force for casting the wax (R., fs. 166-170). On these inescapable predicates the District Court concluded "that the claims are all invalid because anticipated and for want of invention" (R., f. 174).

To the same effect is the decision of the Court of Appeals (R., fs. 175-210). That opinion, after adverting to the admissions of Jungersen's British patent (R., fs. 186-187), said:

> "It is clear from this admission that all but the use of centrifugal casting to force the wax and the metal into their respective moulds was deemed old" (R., f. 187).

It then stated the problem——

> "Thus plaintiff's patent can be sustained only if the use of force to cast the wax and the metal is such a change of a known method as to amount to invention . . ." (R., f. 189).

and, answering it, said:

> "We think it is not. Indeed, the use of applied force to cast metal was shown in several patents prior to the plaintiff's" (R., f. 189).

These "several patents" it then considered in detail (R., fs. 189-191), and concluded that "The combination of such known elements is not invention" (R., f. 199).

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This Court's decision, by Mr. Justice Reed, shows the same reliance upon the printed or patented art as had the decisions of the two lower courts (R., fs. 211-250). At the outset it was said that

> "An examination of the prior art as it existed at the time of this alleged invention reveals that every step in the Jungersen method was anticipated. We think that his combination of these steps was, in its essential features, also well known in the art" (R., f. 223).

That art was then analyzed to show that the general—the lost wax—system was well known and that

> "Long before the issuance of this [Jungersen] patent, however, those skilled in the art recognized and disclosed the necessity for the application of force in order to make molten materials fit snugly the intricate details of the mould" (R., fs. 224-227).

Consideration then was given to the prior patents and publications which had disclosed just that, e.g., Haseltine, Kralund, McManus and Mortimer (R., fs. 227-230). With respect to Jungersen's contention that the use of centrifugal force to force the wax into the primary mold was new, this Court said,

> "We think this fact is of no legal significance. Where centrifugal force was common as a means of introducing molten metal into the secondary mould, its use in an intermediate step to force molten wax into the primary mould was not an exemplification of inventive genius such as is necessary to render the patent valid" (R., fs. 230-231).

The patent in suit was invalidated because it did not disclose invention, and this result would have been impelled even if the Kralund patent had not been in the case. In any event, it is entirely manifest from all three of the opinions in the *Baden* case that Tour's testimony with respect to his experience at Doehler had nothing to do with the result, and it is equally manifest that if the earlier case

were reopened for any reason at all, a rehearing would compel the conclusion there reached.*

It is clear that a fraud which is without effect of any nature, even if proved, would afford no basis for reopening. Such basis is found only where the fraud has been proved and has been shown to have been material. *Pence* v. *United States,* 316 U. S. 332, 338. Thus, in *Toledo Co.* v. *Computing Co.,* 261 U. S. 399, this Court refused to reopen an earlier judgment because it did not "appear that the fraud charged really prevented the party complaining from making a full and fair defense" (261 U. S. 421). To the same effect, certain averments in that case were disregarded as irrelevant because "they are not shown to have had any causal connection" with the failure of the petitioner to make its case (261 U. S. 423). Here the Jungersen patent was invalidated because it did not show invention over the disclosures of prior patents and publications and here Tour's testimony prevented Jungersen from doing nothing that he could have done to validate the invalid. Here there is no "causal connection" between the invalidity of the Jungersen patent and anything testified to by Tour.

To much the same effect is the statement of this Court in *Keystone Co.* v. *Excavator Co.,* 290 U. S. 240, 245. There the question was whether the plaintiff had been guilty of unclean hands, which, if established, amounted to fraud. The Court said (p. 245):

> "But courts of equity do not make the quality of suitors the test. They apply the maxim requiring clean hands only where some unconscionable act of one coming for relief *has immediate and necessary relation* to the equity that he seeks in respect of the

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* The petition here, in effect, concedes this in its statement that "We are concerned here, not with the validity of a patent, nor with the soundness or otherwise of a judgment" . . . (Peto., p. 37) and "Whether or not it can be said that a retrial of the infringement suit . . . would again result in a decision of invalidity . . . it may not operate to mitigate or excuse defendants' fraud" (Peto., p. 41).

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> matter in litigation. They do not close their doors because of plaintiff's misconduct, whatever its character, that has no relation to anything involved in the suit, but only for such violations of conscience as in some measure affect the equitable relations between the parties in respect of something brought before the court for adjudication."

The non-existent fraud which is here alleged had nothing to do with the decisions and gives no reason for reopening.

The Decisions Below are not in Conflict with any Decision of this Court.

Petitioner's sole contention on this score is that the decisions below are in conflict with the decision of this Court in *Hazel-Atlas Co.* v. *Hartford Co.*, 322 U. S. 238.

In fact, there is no conflict.

It would seem a work of supererogation to review that decision in any detail. Suffice it now to note that in 1926 Hartford was having rough sledding in the prosecution of a patent application relating to a method of glass blowing. To surmount this difficulty, it caused an article extolling the method to be prepared and published and caused this article to be signed by the president of a glass blowing labor union who had had nothing to do with its composition (322 U. S. 240). The article won over the Patent Office, the patent issued, and Hartford sued Hazel for infringement. In the District Court the article was not relied on and Hartford lost. Upon appeal, the article was brought before the Court and the latter, heavily relying on it, reversed (322 U. S. 241). Years later, after the fraud had been clearly exposed, Hazel moved to reopen and set aside the earlier judgment (322 U. S. 243). The Court of Appeals for the Third Circuit denied the motion (137 F. 2d 764) and this Court reversed.

The decision of this Court in the *Hazel* case clearly establishes the right of a court to reopen a judgment

tainted with fraud, without regard to the term. That decision does not establish, however, that the mere allegation of fraud, or even the proof of immaterial fraud, is sufficient.

Three essential distinctions between the *Hazel* case and this case are illustrated by the following quotation from this Court's decision (322 U. S. 245-246):

> "Every element of the fraud here disclosed demands the exercise of the historic power of equity to set aside fraudulently begotten judgments. This is not simply a case of a judgment obtained with the aid of a witness who, on the basis of after-discovered evidence, is believed possibly to have been guilty of perjury. Here, even if we consider nothing but Hartford's sworn admissions, we find a deliberately planned and carefully executed scheme to defraud not only the Patent Office but the Circuit Court of Appeals. Cf. *Marshall* v. *Holmes, supra.* Proof of the scheme, and of its complete success up to date, is conclusive. Cf. *United States* v. *Throckmorton, supra.*"

(1) The *Hazel* case was *not* one involving "a judgment obtained with the aid of a witness who . . . is believed possibly to have been guilty of perjury". Here, the most that can be said for Jungersen is that this *is* such a case.*

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* In Jungersen's complaint and in his affidavits he charged that Tour's testimony was part of a "plan" "to convince the trial court that each step in plaintiff's method *was anticipated* . . . [and] thus to deceive and defraud the court and to influence the court in holding plaintiff's patent invalid" (Compl., Paras. Twelfth, Thirteenth, R., fs. 19-21). Another part of the "plan", according to Jungersen, was the action of Baden, another witness, in having lied as to the date he commenced practicing the challenged method. Here again the charge is not substantiated, but in any event it is meaningless, since Baden testified to a date which was more than a year after the application for the Jungersen patent had been filed (cf. R., fs. 395 and 11).

In the petition here, however, substantially all phases of the "plan" are ignored (see, though, Peto., pp. 3, 30-31, 36) except for Tour's asserted perjury.

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(2) In the *Hazel* case the fraud was shown by "Hartford's sworn admissions" (332 U. S. 245, 250). There the essential facts "were shown by the record without dispute" (322 U. S. 240), and "proof of the scheme . . . [was] conclusive" (322 U. S. 246). And, again and again, this Court used such expressions as "indisputable proof" (322 U. S. 243), "undisputed evidence" (322 U. S. 247).

Here, in contrast, there is no proof, indisputable or otherwise, and here there are no admissions. The sole substantiation for Jungersen's charges is the first Pack affidavit and, to give this even the slightest effect, the second Pack affidavit must be utterly ignored. In this connection it is pertinent that an affidavit filed by one of Jungersen's counsel says he has studied "voluminous papers" and "conducted extensive investigations which entailed traveling to various states for the purpose of interviewing people who had knowledge which would effect [sic] the decision as to whether to institute this action" (R., fs. 506-507; see also, Peto., p. 38), but not one of the "papers" has been produced, and, for all his traveling, he has not produced a single witness to substantiate Jungersen's position.

(3) In the *Hazel* case "Proof of the scheme, and of its complete success up to date [was] conclusive . . ." And the conclusiveness is illustrated by the fact that the article certainly had overcome the "apparently insurmountable Patent Office opposition" to its issue (322 U. S. 240-241); its non-use in the District Court resulted in a lost case (322 U. S. 241) and its use in the Court of Appeals won the day (322 U. S. 241).

Here, even if a scheme had been shown—and there isn't a scintilla of evidence that there ever was one—it has been demonstrated that it had no effect of any nature on the result.

This case lacks every element which impelled the result in the *Hazel* case. The decisions below in no way conflict with the decision there.

Conclusion

The decisions below were correct. This case affords no reason for the award of a writ of certiorari.

Respectfully submitted,

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